Supreme Court, U.S.
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No. ——

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

UNITED STATES SURGICAL CORPORATION,
Petitioner,

v.

ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether patent claim construction for use in infringement and obviousness analysis is a matter exclusively for the court, as the Court of Appeals for the Federal Circuit recently held *en banc*, or for the jury, as the District Court and a panel of the Federal Circuit held in this case?

2. Whether the Court of Appeals for the Federal Circuit, when it summarily affirmed the judgment so as not to apply a soon-to-be-issued *en banc* ruling that would require a new trial in this case, so far departed from the usual and accepted course of judicial proceedings as to call for the exercise of this Court's power of supervision?

3. Whether the Court of Appeals for the Federal Circuit, when it condoned the jury's use of a non-evidential dictionary and refused to apply the presumption of prejudice arising from the jury's use of extraneous matter, was in direct conflict with controlling Second Circuit authority, as well as decisions of other federal (and state) courts?

4. Whether the Court of Appeals for the Federal Circuit, when it summarily affirmed the judgment in clear conflict with controlling Second Circuit authority requiring a new trial because of the jury's use of extraneous non-evidential matter, so far departed from the usual and accepted course of judicial proceedings as to call for the exercise of this Court's power of supervision?

LIST OF PARTIES

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of *Certiorari.*

LIST OF PARTIES PURSUANT TO RULE 29.1

Petitioner United States Surgical Corporation is a publicly held corporation with no parent companies. There are no subsidiaries or affiliates of United States Surgical Corporation that have issued shares to the public.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner United States Surgical Corporation ("U.S. Surgical") respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit ("CAFC") in the above-captioned case.

OPINIONS BELOW

The post-trial rulings of the District Court are unreported and are reproduced in the Appendix at App. 2a. The summary affirmance of the CAFC is unreported and is reproduced at App. 1a. The CAFC order denying rehearing is unreported and is reproduced at App. 32a.

JURISDICTION

The judgment of the CAFC was entered on February 14, 1995. App. 1a. U.S. Surgical filed a timely petition for rehearing and suggestion for rehearing *en banc*, which was denied on March 23, 1995. App. 32a. This Court has jurisdiction to review the judgment of the Court of Appeals pursuant to 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

U.S. Surgical obtained two patents, the '420 patent and the '057 patent, on the first endoscopic multiple clip applier, a medical instrument used primarily in endoscopic gallbladder operations. U.S. Surgical enjoyed immediate and great market success with its commercial embodiment, the ENDOCLIP.™ More than a year later, Ethicon, Inc. ("Ethicon"), a subsidiary of Johnson & Johnson, entered the market with its own endoscopic multiple clip applier, the EMCA, soon followed by the ERCA. U.S. Surgical brought suit in the United States District Court for the District of Connecticut contending that Ethicon's clip appliers infringed claim 1 of the '420 patent and claims 1, 2, and 7 of the '057 patent. Ethicon denied infringement and also contended these claims were "obvious" under 35 U.S.C. § 103.

Prior to the *en banc* decision of the CAFC in *Markman v. Westview Instruments, Inc.*, 34 USPQ2d 1321 (April 5, 1995), that court's precedents were in conflict concerning the respective roles of the court and jury in ascertaining the scope and meaning of patent claims in jury trials.[1] One line of CAFC precedents, culminating in *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H*, 945 F.2d 1546 (Fed. Cir. 1991), took the position that claim construction may have underlying factual

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[1] Chief Judge Archer, the author of the majority opinion in *Markman*, fully sets out the conflicting lines of CAFC precedent in Part III of his opinion, 34 USPQ2d at 1327-29.

inquiries that have to be submitted to a jury. The *Tol-O-Matic* line of cases encouraged trial courts not to give meaning-specific instructions but to submit unconstrued claims to a jury. Another, older line of CAFC precedents, culminating in *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992), took the position that construction of a patent claim was a matter of law exclusively for the court. Under *Read*, the jury receives meaning-specific instructions construing the claims, leaving no issue of construction for the jury. The jury then determines whether the accused device infringes the claims as defined for it.

The correct allocation of role between court and jury in claim construction is of immense importance not only in patent infringement analysis but also in "obviousness" analysis. The reason is that in an obviousness analysis the prior art must be compared to a properly construed claim; otherwise, the comparison of the prior art with the controverted claim will be clearly erroneous. *Smithkline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 885 (Fed. Cir. 1988); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Proponents of the *Read* line of cases maintain that having the court construe claims for the jury promotes predictability and consistency in both infringement and obviousness determinations, because a fully instructed jury will utilize the same claim construction (as given in the charge) in resolving both issues.

The CAFC recognized that it had divergent lines of cases and that the respective role of court and jury was of crucial importance in patent enforcement. For that reason, when the issue was presented in *Markman*, the CAFC, after oral argument on May 7, 1992 but before the panel's decision issued, took the highly unsual step, on November 5, 1993, of ordering *en banc* consideration. On January 7, 1994, the Court sought briefing on four questions that focused on the respective role of court and

jury in patent enforcement. App. 42a. The Court heard *en banc* argument on May 4, 1994.

U.S. Surgical filed suit for patent infringement on March 10, 1992, and at all times took the position that claim construction was a matter exclusively for the court, in accordance with the *Read* line of cases. Ethicon, the alleged infringer, sought refuge in the *Tol-O-Matic* line of cases. The special master, who initially ruled upon motions for summary judgment, sided with U.S. Surgical: "The jury's sole role is to determine whether the invention, as defined by the Court, has been made and sold by the defendants. *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992)." App. 41a. The special master recommended that the District Court, after consideration of expert evidence to aid it in its claim interpretation, "formulate appropriate instructions for the jury on the meaning of the claim . . ." *Id.* The Court (Eginton, J.) endorsed the recommendation of the special master.

But the case was then reassigned. The trial was in significant measure consumed by disputes over the scope and meaning of the claims at issue.[2] The new judge (Covello, J.), following *Tol-O-Matic*,[3] declined to define the meaning of the claims for the jury. App. 8a, App. 24a-26a. Instead, he opted for instructions that in the most general terms describe the approach the jury should take in construing a patent claim. He informed the jury

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[2] Each side presented its position through legal "experts" who offered conflicting views on the meaning of the patent claims, as well as on other legal issues, including the meaning of 35 U.S.C. § 103. As was clear under the *Read* line of cases, that testimony did not relieve the trial court of its obligation to construe the claims for the jury. This point is directly made in *Markman*, 34 USPQ2d at 1333.

[3] The trial court was acutely aware that the CAFC had two conflicting lines of cases, culminating in *Tol-O-Matic* and *Read*. App. 24a-26a.

that he had determined that there was a factual dispute concerning the meaning of the claims, and for that reason it was the jury's function to construe the claims and determine their meaning.[4] U.S. Surgical, which had submitted comprehensive, meaning-specific instructions construing the claims as required by *Read* (*see* App. 24a note 26), excepted to the Court's refusal to give meaning-specific jury instructions.

Left with a unconstrued claims, the jury, unguided and adrift, requested a dictionary on the first day of its deliberations. Over the objection of both parties, and without inquiry as to the need or intended use of the dictionary, the District Court answered the jury's request by providing it with Webster's *New World Dictionary*. *See* App. 30a-31a.

The jury returned a verdict that the accused EMCA and ERCA devices infringed claim 1 of the '420 patent but did not infringe claims 1, 2, and 7 of the '057 patent. The jury further found that all four claims were "obvious."

The District Court denied U.S. Surgical's post-trial motions. App. 2a. It relied upon *Tol-O-Matic* in defense of its position that it was not obliged to define the claims for the jury. App. 24a-26a. The Court admonished the parties not to talk to the jury, in accordance with its local Rule 12(f) prohibiting interviews of jurors. The Court ignored U.S. Surgical's request for a hearing to determine what use the jury made of the dictionary. *See* App. 30a-31a. It refused to apply the Second

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[4] To be accurate, there were any number of disputes, as the District Court correctly noted in its post-trial rulings. App. 24a. The Court did not define the parameters of any of the disputes for the jury. The parties had set forth their respective differences on claim charts that were the subject of extensive testimony. Under the *Read* line of cases, followed in *Markman*, these disputes do not create a factual issue for the jury, because it is the sole province of the court to interpret the claims and instruct the jury on their meaning.

Circuit's presumption of prejudice arising from the jury's use of the dictionary. To the contrary, it placed the burden on U.S. Surgical to demonstrate actual prejudice due to the dictionary. App. 31a. Of course, U.S. Surgical could not demonstrate actual prejudice after the Court refused to allow juror interviews and denied its request for a hearing.

On appeal to the CAFC, U.S. Surgical strenuously argued that it was entitled to a new trial because of the District Court's failure to construe the claims for the jury. Brief for Plaintiff-Appellant, pp. 34-35, 43-44, 49-50; Reply Brief for Plaintiff-Appellant, pp. 18-20. U.S. Surgical relied upon the *Read* line of cases; *Read* even was featured in its summary of argument. App. 45a. U.S. Surgical also argued that it clearly was entitled to a new trial because under controlling precedent of the Second Circuit, *United States v. Weiss*, 752 F.2d 777, 782-83 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985),[5] submission to the jury of non-evidential extraneous matter (the dictionary) was presumptively prejudicial, Ethicon had not rebutted the presumption of prejudice (which it had no means of doing in the absence of a hearing, in light of local Rule 12(f)), and therefore the CAFC had no legal alternative but to order a new trial. Brief for Plaintiff-Appellant, pp. 45-47, 50.

The case was argued before a panel of the CAFC on February 6, 1995. The panel consisted of Circuit Judges Newman and Rader, and Senior Circuit Judge Bennett. Judge Newman, who chaired the panel, was the author of the *Tol-O-Matic* opinion, and she had been joined in that opinion by Judge Rader (along with Senior Circuit Judge Skelton). On February 14, 1995, eight days after

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[5] The District Court's submission of the dictionary to the jury raises a trial issue not within the CAFC's unique jurisdiction. The controlling law is therefore that of the regional circuit in which the case was tried. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 855-58 (Fed. Cir. 1991), *cert. denied*, 112 S. Ct. 2957 (1992).

oral argument, the panel affirmed the judgment in this case without opinion. App. 1a. The panel invoked Federal Circuit Rule 36, which permits the entry of a judgment of affirmance without opinion in five limited circumstances, including affirmance of a judgment or decision "entered without error of law" and "an opinion would have no precedential value." App. 46a.

U.S. Surgical petitioned for rehearing and rehearing *en banc*. It argued to the panel that it was entitled to a reasoned explanation as to why submission of the dictionary to the jury did not mandate a new trial, in light of the contrary and controlling Second Circuit precedent, *United States v. Weiss*, *supra*. U.S. Surgical also pointed out that the CAFC's affirmance of the trial court's decision on the dictionary point was a departure from all available precedent regarding the jury's use of a non-evidential dictionary. In addition to the dictionary issue, U.S. Surgical argued to the CAFC as a whole that it should defer further consideration of U.S. Surgical's appeal pending the outcome of *Markman*, which had been argued and submitted to the court more than nine months earlier. U.S. Surgical also made the point that resort to Federal Circuit Rule 36 was totally inappropriate in light of the highly meritorious issues that it had raised on appeal, including the very same issue *sub judice en banc* in *Markman*. The CAFC denied U.S. Surgical's petition without comment on March 23, 1995. App. 32a.

Less than two weeks later, on April 5, 1995, the CAFC issued its long-awaited *en banc* decision in *Markman*. Eight of the eleven active judges ruled that claim construction was a matter of law *exclusively* for the court, in accordance with the *Read* line of cases. 34 USPQ2d at 1332. "We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and the obligation to construe as a matter of law the meaning of language used in the patent claim." 34 USPQ2d at 1329.

Circuit Judge Newman, who had chaired the panel in U.S. Surgical's appeal, filed an extensive dissent. She amplified on her view, as expressed in her overruled *Tol-O-Matic* opinion, that the jury had a significant role in claim construction. 34 USPQ2d at 1346-68. Circuit Judge Rader, who had joined Judge Newman's opinion in *Tol-O-Matic*, concurred in the judgment; however, he saw no need to reach the issue decided by the *Markman en banc* majority. 34 USPQ2d at 1345-46. Circuit Judge Mayer, whose views on the role of court and jury were similar to Judge Newman's, also concurred in the judgment. 34 USPQ2d at 1337-45.[6]

In *Markman*, the CAFC *en banc* decisively rejected the *Tol-O-Matic* line of cases. The *Markman* holding that claim construction is a matter of law exclusively for the court is exactly the position that U.S. Surgical advocated in the trial court and on appeal, only to have its position rejected on appeal because the active judges randomly assigned to its panel (Newman, Rader, JJ.) happened to be two of only three active CAFC judges not in agreement with the *Read* line of cases and the *Markman* majority. Their determination not to bow to their colleagues was underscored further when they refused to apply *Markman* in *Pirkle v. Ogontz Controls Co.*, No. 94-1454 (April 6, 1995). *Pirkle* was argued on the very day that the *Markman* decision was released, and was summarily affirmed the next day. Circuit Judges Newman and Rader again invoked Federal Circuit Rule 36 to avoid issuing a decision explaining their refusal to apply *Markman*.[7]

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[6] The third member of the *U.S. Surgical* panel, Senior Circuit Judge Bennett, and the third member of the *Tol-O-Matic* panel, Senior Circuit Judge Skelton, did not participate in the *Markman en banc* decision due to their senior status.

[7] The *Pirkle* panel consisted of Newman and Rader, JJ. and Senior Circuit Judge Skelton, the same panel that decided *Tol-O-Matic*. Counsel for Pirkle was unaware that *Markman* was being released on the day of his argument. In his petition for rehearing

REASONS FOR GRANTING THE WRIT

I. THIS COURT SHOULD RESOLVE, ONCE AND FOR ALL, THE RESPECTIVE ROLES OF COURT AND JURY IN DECIDING THE MEANING OF PATENT CLAIMS

The single most important issue in a jury-tried patent case is the proper role of court and jury in deciding the meaning of patent claims. This issue is present in every jury patent case in which the alleged infringer disputes the meaning of words and phrases in a patent claim, that is, in virtually every jury patent case. The issue is of vital importance because correct claim construction is the crucial first step in both infringement and obviousness analyses.[8] Federal trial courts often have submitted issues of claim interpretation to the jury rather than instruct the jury on the meaning of the claim. That is precisely what occurred in this case, as well as in *Markman*.

In her dissent from the CAFC's denial of rehearing *en banc* of the panel decision in *In re Lockwood*, 33 USPQ2d 1907, 1908 (Fed. Cir. 1995), *cert. granted*, 63 U.S.L.W. 3857 (June 6, 1995), Judge Nies wrote: "No more important nor contentious issue arises in patent law jurisprudence than the appropriate role of juries in patent litigation." It is of paramount importance that this Court authoritatively settle the role of court and jury in ascertaining the meaning of patent claims. This issue has arisen far more frequently, and is of greater national importance than the *Lockwood* issue, which involves the

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Pirkle protested that the Rule 36 disposition "would appear to have been a clerical mistake," but the petition was denied. (Senior Judge Skelton voted to rehear.) Counsel for Pirkle has advised that Pirkle plans to file a petition for *certiorari* by mid-July, well in advance of its due date of August 22, 1995.

[8] Alleged obviousness under 35 U.S.C. § 103 is surely the most common invalidity defense.

role of court and jury in a patent declaratory judgment action seeking an invalidity declaration.[9]

For the reasons set forth in Chief Judge Archer's *Markman* opinion, it is important that the trial court construe the claims as a matter of law for the jury. It should do so through meaning-specific instructions that review for the jury the exact meaning of each claim element, as U.S. Surgical requested. A jury is not in a position to determine either infringement or obviousness if it is not properly charged on the meaning of the claims. It was no surprise that the jury below called for a dictionary; it was adrift and sorely in need of direction.

When the claims are not construed at all for the jury, as occurred in the District Court, then the risk is that issues of infringement and obviousness are decided by the jury totally devoid of the legal guidance needed for rational decision-making. With respect to infringement, the jury cannot perform its role of determining whether the accused device infringes because the claim has not been construed for the jury to compare the accused device to the correctly construed claim. The same is true for obviousness. The jury cannot properly compare the claim with the prior art unless it knows what the claim means. Claim construction by the court is also the best insurance against the very real danger that a jury will apply one claim meaning in determining infringement but another claim meaning in determining obviousness. See p. 3, *supra*.[10] It is essential to proper patent enforce-

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[9] In *Lockwood*, the question presented is: "In an action in which the sole claim to be tried is a claim under the Declaratory Judgment Act to have a patent declared invalid, is there a right to a jury trial under the Seventh Amendment of the United States Constitution?" Petition for writ of *certiorari*, *American Airlines, Inc. v. Lockwood*, No. 94-1660, p. i.

[10] For example, the jury might apply too narrow a meaning to defeat infringement or, conversely, too broad a meaning to defeat non-obviousness. Its approach also may not be consistent from one claim to another.

ment that a jury apply the same meaning to the claim in both infringement and obviousness analyses.[11]

At its core, the proponents of *Tol-O-Matic*, with considerable justification, perceive that *Markman* means that juries henceforth will have little or no role in most patent cases. On the infringement side, the disputed issue typically relates to the meaning of the claim; once the meaning is fixed, then an accused device either does or does not infringe, with no room in most cases for factual debate. On the obviousness side, the disputed issue also often relates to the meaning of the claim; the other considerations—the scope and content of the prior art and the level of ordinary skill in the art—usually are not disputed. Furthermore, with respect to the obviousness analysis, there is a strong argument that a jury in any event has no constitutional role, as Judge Nies suggests in her *Lockwood* dissent. *In re Lockwood*, *supra*, 33 USPQ2d at 1916.

While the indisputable effect of *Markman* will be to curtail the role of a jury in patent trials, *Markman* also underscores the essential and constitutional role of a Federal judge in patent cases. Even in jury-tried patent cases, the judge must be more than a moderator. As this Court so well stated in *Herron v. Southern Pacific Co.*, 283 U.S. 91, 95 (1931):

> In a trial by jury in a federal court, the judge is not a mere moderator, but is the governor of the trial for purpose of assuring its proper conduct and of

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[11] In *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718 & n.7 (Fed. Cir. 1994), the court stated that a jury, unless properly instructed, functioned as the proverbial "black box into which patents are thrown [to] emerge intact or invalid by an unknown or unknowable process." U.S. Surgical used the "black box" analogy from *Structural Rubber* in its summary of argument in its opening CAFC brief. App. 44a. The purpose was to stress that the jury had no legal guidance on the meaning of the claims from the trial court. Judge Nies in her forceful *Lockwood* dissent also referred to the "black box" analogy. 33 USPQ2d at 1916.

> determining questions of law. This discharge of the judicial function as at common law is an essential factor in the process for which the Federal Constitution provides.

In a jury-tried patent case, a failure to inform the jury what a patent means is no different from a negligence case in which the court provides a highly general charge on negligence but fails to relate the charge to possible alternatives under the facts of a case, so that the jury is faced with abstract concepts of no utility in guiding their deliberations. *E.g., McNello v. Kelly*, 283 F.2d 96, 102 (3d Cir. 1960) ("Few more fundamental errors with respect to a charge can be conceived.").[12] The error is even worse in patent cases, which are often far removed from the experience of most jurors. Also, litigants (especially alleged infringers) in patent cases often are especially disputatious about the meaning of words and phrases in patent claims, and the jury therefore needs clearcut instruction on the meaning of the claims at issue. It is imperative, therefore, that the judge construe patent claims and not leave their construction to the jury.

The CAFC's *en banc Markman* decision is of enormous importance because it clarifies that claim construction must be worked out in advance of instructing the jury, precisely as U.S. Surgical had urged based on the *Read* line of cases. The CAFC correctly reasoned that the jury had no role in claim construction because this process is comparable to statutory interpretation and, therefore, a matter of law strictly for the court. 34 USPQ2d at 1336. *Markman* requires federal trial judges

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[12] Additional examples include *Latsis v. Chandris, Inc.*, 20 F.3d 45 (2d Cir. 1994) (failure to give proper Jones Act instruction), *aff'd*, 1995 WL 352858; *MacEdward v. Northern Electric Co.*, 595 F.2d 105 (2d Cir. 1979) (absence of instructions on key issues). These are "plain error" cases; reversal occurred because of "fundamental error" and despite the absence of properly preserved objections. In contrast, U.S. Surgical submitted meaning-specific instructions and excepted to the court's failure to give them.

to resolve contentions over the meaning of claims in advance of instructing the jury. This represents a "sea change" (as Judge Mayer noted, 34 USPQ2d at 1337) in the approach previously taken by many federal trial judges, including the trial judge in this case. *Markman's* deep and direct effect on the conduct of most patent trials makes it perhaps the single most important patent case decided by the CAFC in its history.

But, as this Court will see when it reviews the petition for *certiorari* in *Markman*,[13] the opposition thereto, and the *amici* briefs expected to be filed, there is strong merit in Judge Mayer's concurring opinion in *Markman* in which he predicts that the CAFC's *Markman* decision "portends turbulence and cynicism in patent litigation." 34 USPQ2d at 1337. Because *Markman* has the effect of severely curtailing jury trials in patent cases,[14] *Markman* will not receive general acceptance unless and until this Court agrees that it correctly defines the respective roles of court and jury in resolving disputes over the meaning of patent claims. This important jury question therefore should be resolved definitively by this Court.

If this Court grants *certiorari* in *Markman*, it also should grant *certiorari* in this case, and consolidate it for argument with *Markman*. The record in this case,[15] including the comprehensive instructions that U.S. Surgical

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[13] Counsel for appellant *Markman* has advised undersigned counsel that *Markman* will file a petition for *certiorari* on or before its due date of July 5, 1995.

[14] As Judge Nies points out in her *Lockwood* dissent, the majority of patent cases in recent years (up to 70%) have been tried to a jury. In re *Lockwood*, 33 USPQ2d at 1908 n.1. This will greatly change after *Markman*.

[15] This case presents a clear picture of the failure of the adjudicative process (as exemplified by the jury's request during its deliberations for a dictionary) when the trial court, following *Tol-O-Matic*, declined to give the jury meaning-specific instructions.

provided for the purpose of informing the jury on the claims' meaning, will be of invaluable aid in demonstrating to this Court why it is so important that trial courts define the claims for the jury as a matter of law through meaning-specific instructions. It will make clear that a patentee cannot obtain a meaningful trial when, as in this case, the trial court abdicated its responsibility to inform the jury and functioned merely as a moderator.

Alternatively, if this Court grants *certiorari* in *Markman*, it should hold this case pending the outcome of *Markman*. If *Markman* is affirmed, then *certiorari* should be granted in this case, and this case remanded for further consideration in light of this Court's decision. On the other hand, if this Court denies *certiorari* in *Markman*, then, at that time, it should grant *certiorari* in this case and remand it to the CAFC for reconsideration in light of *Markman*.

II. THE REFUSAL OF THE COURT BELOW TO APPLY ITS OWN *EN BANC MARKMAN* DECISION TO THE INSTANT APPEAL WAS A MARKED DEPARTURE FROM ACCEPTED APPELLATE PRACTICE, REQUIRING AN EXERCISE OF THIS COURT'S SUPERVISORY POWER

For years, the CAFC allowed two lines of precedent to coexist, the *Read* line that promoted proper adjudication of infringement and obviousness in patent cases by requiring the court to construe the patent claim for the jury, and the *Tol-O-Matic* line in which the court, on account of the parties' differing construction of claims, allowed the jury to decide what the claim means with little or (as in this case) no guidance from the court. U.S. Surgical steadfastly urged the *Read* approach. It succeeded at one point in having the District Court declare the *Read* approach to be the proper one, only to find that the new judge assigned to try the case insisted upon following *Tol-O-Matic*.

The CAFC fully appreciated that it needed to resolve the intra-circuit conflict on the role of court and jury in claim construction. It knew that there was no issue more important in jury-tried patent cases. That is why it ordered *en banc* consideration in *Markman*, and solicited additional briefing, including from *amici*. It received new briefs, including from numerous *amici*, in early 1994. It heard argument *en banc* on May 4, 1994. The various opinions in *Markman* show that all active judges regarded the correct delineation of the role of court and jury in claim construction as an issue of great importance.

But then, inexplicably, the CAFC panel assigned to the U.S. Surgical appeal, with the long-awaited *Markman* decision nearing release, refused to apply what soon would emerge publicly as the strong majority view on the claim construction point. Then, when U.S. Surgical requested in its petition for rehearing that its appeal be held until after the *Markman* decision, the Court refused to delay the appeal, notwithstanding, or perhaps because of, U.S. Surgical's strong emphasis on the *Read* case. The panel's summary affirmance and denial of U.S. Surgical's petition for rehearing thwarted petitioner's efforts to have its case decided after the CAFC *en banc* resolved the conflict between *Read* and *Tol-O-Matic*.

The accepted practice of this Court, and of any well-ordered appellate court, when it knows that it has under active *en banc* consideration a case whose outcome directly may affect other cases, is to defer the others pending resolution of the lead case.[16] In this case, the two *Tol-O-Matic* judges, through precipitous action and im-

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[16] For example, this Court deferred consideration of the *certiorari* petition of Montedoro-Whitney Corp. pending the outcome of this Court's decision in *Firstier Mortgage Co. v. Investors Mortgage Insurance Co.*, 111 S.Ct. 648 (1991). It then remanded for reconsideration in light of its decision. *Montedoro-Whitney Corp. v. Marsh-McBirney, Inc.*, 111 S.Ct. 775-76 (1991). This is the accepted appellate practice.

proper invocation of Federal Circuit Rule 36,[17] managed to impose their idiosyncratic views in a summary affirmance. Surely, the panel had an obligation to defer review of U.S. Surgical's appeal in light of the imminent *en banc* resolution of *Markman*. The Rule 36 disposition by the panel had the additional effect of allowing the panel to avoid publishing any reasons for its decision. Under these circumstances, U.S. Surgical could not comply with either the Federal Appellate or Federal Circuit rules for filing rehearing petitions, because it could not identify specific points of law or fact allegedly overlooked or misapprehended by the panel. Fed. R. App. P. 40(a); Fed. Cir. Rule 40(b)(2). The inability to appeal to the CAFC *en banc* is underscored by the *Pirkle* case, in which the CAFC *en banc* declined to intervene despite the panel's refusal to follow *Markman* after *Markman* was decided. See p. 8 and note 7, *supra*. Thus, as a practical matter, Rule 36 effectively cuts off appeal without the possibility of *en banc* review.

The effect of the CAFC's marked departure from accepted appellate practice in suppressing a major appeal on an issue of great concern to the CAFC as a whole was not only to deny U.S. Surgical its appellate rights but to tarnish the fair administration of justice. Petitioner can do no better than to recall the wise words of Chief Judge John R. Brown, when he recoiled at the notion that the Fifth Circuit ever would invoke its counterpart of Federal Circuit Rule 36 "to avoid making a difficult or troublesome decision or to conceal divisive or disturbing issues." *N.L.R.B. v. Amalgamated Clothing Workers*, 430 F.2d 966, 972-73 (5th Cir. 1970). He promised sparing use.[18] *Id.*, and went on to say:

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[17] Needless to say, Rule 36 does not provide for summary affirmance when there is an error of law (as in this case, under the *Read* line of precedents). *See* App. 46a. None of the limited circumstances authorizing the use of Rule 36 arguably existed in this case.

[18] In stark contrast, in the latest six-month period for which compiled data is available (January 1994 through June 1994), the

> The Court itself must be vigilant. We believe we are sensitive now to the factors which would make application of the Rule wrong or unwise or inappropriate. It is the Court's purpose to heed them and in our own survival assure survival of the system we cherish. *Id.*

The panel's refusal to address clearcut conflict in CAFC precedent is, of itself, highly unusual, and a clearcut abuse of Rule 36. But the panel's rush to decide U.S. Surgical's appeal in advance of *Markman*, with Rule 36 as the vehicle, is a truly extraordinary abdication of appellate responsibility. This Court, in the exercise of its supervisory power, should rectify this extreme departure from the usual and accepted appellate practice in this case through summary reversal that requires the CAFC to address the effect of *Markman* upon U.S. Surgical's appeal.[19]

CAFC invoked its Rule 36 to dispose of 44% of all appeals from district courts. Brief for Amicus Curiae Federal Circuit Bar Association, *CPC International, Inc. v. Archer Daniels Midland Co.*, Appeal Nos. 94-145, -1060, 4 Fed. Cir. Bar. J. 269, 294 (1994). The Federal Circuit Bar has criticized the CAFC for its excessive and inappropriate reliance on Rule 36 to avoid reasoned decisions in the face of clearcut conflict in precedent. *See generally id.*, pp. 269-304. This case presents an example of extreme misuse because the conflict in CAFC precedent was well-known to the bench and bar, as evidenced by the District Court's opinion, App. 24a-26a, and the CAFC *en banc* was soon to announce its resolution of the conflict contrary to the District Court's position.

[19] The CAFC then likely will remand to the District Court for a new trial because, unlike in *Markman*, the District Court in this case did not (and in the context of this case could not) render its failure to instruct the jury on the meaning of the claims harmless through its post-trial rulings. See *Markman*, 34 USPQ2d at 1331.

III. THE DECISION BELOW, ALLOWING THE JURY TO USE A NON-EVIDENTIAL DICTIONARY, WAS IN CONFLICT WITH BINDING SECOND CIRCUIT PRECEDENT, AS WELL AS GENERAL FEDERAL AND STATE PRECEDENT CONDEMNING SUCH USE, AND CREATES A DIVISION OF AUTHORITY THAT REQUIRES THIS COURT'S RESOLUTION

On procedural issues, such as the legal effect of a jury's use of extraneous, non-evidential matter in its deliberations, the CAFC defers to the law of the regional Circuit in which the case was tried. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 855-58 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 2957 (1992). In this case, the Second Circuit Court of Appeals is the relevant regional Circuit and, under its leading case, *United States v. Weiss*, 752 F.2d 777, 782-83 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985), the District Court's submission of extraneous matter (the dictionary) to the jury, over the objection of both parties, without any rebuttal of the presumption of prejudice, required a new trial.

The dictionary issue is important because federal courts in patent cases should not be allowed to avoid their obligation to make sure that juries fully understand terms of art in patent cases (*e.g.*, "obviousness" or "presumption" as used in "presumption of validity") through the expedient of providing a jury with a dictionary. On a more general level, the dictionary issue also is important because, until this case, both federal and state courts have been deeply sensitive to the taint that can accrue when the jury is able in effect to make its own law through the unauthorized use of extraneous sources that were not introduced into evidence. Finally, the issue is important because the CAFC should not be allowed to apply its own rule on this type of procedural issue, but should be required to apply the law of the relevant regional circuit.

As set forth in all standard jury instructions, including those used by the trial court in this case, a jury should decide a case *solely* upon the evidence adduced at trial. *Palestroni v. Jacobs*, 77 A.2d 183 (N.J. Super. 1950) (Brennan, J.) (a dictionary case). The presumption of prejudice comes into play because of the jury's use of non-evidential matters in its deliberations. The presumption sometimes can be rebutted, but it is not possible to do so in the absence of a hearing, which the District Court declined to order. *See, e.g., United States v. Weiss*, 752 F.2d at 782-83.

Prior to this case, appellate courts universally have condemned the practice of exposing a jury to dictionaries or any other matter not properly admitted into the record. Indeed, every federal court of appeals that has addressed this issue—other than the court below—considers submission of a dictionary to a deliberating jury to be error.[20] Until now, when exposure to a dictionary results in prejudice, either presumptively or actually, courts have been unanimous as to the result: the judgment is vacated, and a new trial is ordered.[21] This result obtains irrespective

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[20] *See, e.g., United States v. Martinez*, 14 F.3d 543, 548, 550, 552 (11th Cir. 1994) (applying presumption of prejudice); *Mayhue v. St. Francis Hosp.*, 969 F.2d 919, 922-26 (10th Cir. 1992) (presumptively prejudicial); *United States v. Turner*, 936 F.2d 221, 226 (6th Cir. 1991) (use of dictionary "error"); *United States v. Cheyenne*, 855 F.2d 566, 567 (8th Cir. 1988) (use of dictionary "improper jury conduct"); *Marino v. Vasquez*, 812 F.2d 499, 502, 505-07 (9th Cir. 1987) ("reversible error"); *United States v. Duncan*, 598 F.2d 839, 867 (4th Cir.), *cert. denied*, 444 U.S. 871 (1979) (reference to dictionary "misconduct"). State courts agree. *See, e.g., State v. Asherman*, 478 A.2d 227, 252 (Conn. 1984), *cert. denied*, 470 U.S. 1050 (1985) (judge not "authorized to furnish dictionary"); *Wernsing v. General Motors Corp.*, 470 A.2d 802, 809 (Md. 1984) (refusal to grant new trial prejudicial error).

[21] *See, e.g., Martinez*, 14 F.3d at 548, 550, 552; *Mayhue*, 969 F.2d at 922-26; *Marino*, 812 F.2d at 502, 505-07; *Fulton v. Callahan*, 621 So.2d 1235, 1247-50 (Ala. 1993); *Glage v. Hawes Firearms*, 276 Cal. Rptr. 430, 432-38 (Ct. App. 1990); *State v. Abell*, 383

of whether the case is civil or criminal, or whether the source of the dictionary is a juror, the bailiff, or the trial court.[22]

It was obvious error for the District Court to give the jury a dictionary.[23] The parties, of course, instantly recognized that the Court's action was error: both objected, to no avail. Even though the burden was then to Ethicon (as the prevailing party before the jury) to rebut the presumption of prejudice, U.S. Surgical requested a hearing on the jury's use of the dictionary, but the District Court ignored that request. *See* App. 30a-31a. At the trial level, the presumption of prejudice stood unrebutted.

It is of great importance that this Court correct the conflict created by the CAFC's refusal to implement the presumption of prejudice. The decision below not only created a conflict with the Second Circuit, as well as other federal and state precedent, but did so in a context in which the CAFC was obligated by its own precedent to follow the law of the Second Circuit on an important procedural issue. A decision by this Court, eliminating

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N.W.2d 810, 812-13 (N.D. 1986); *Priest v. McConnell*, 363 N.W.2d 173, 179 (Neb. 1985); *Alvarez v. People*, 653 P.2d 1127, 1130-32 & n.11 (Colo. 1982) (*en banc*); *Dongo v. Banks*, 448 A.2d 885, 888-89 (Me. 1982); *Creasey v. Hogan*, 637 P.2d 114, 122-25 (Or. 1981); *State v. Holmes*, 522 P.2d 900, 905 (Or. App. 1974); *Gertz v. Bass*, 208 N.E.2d 113, 115-17 (Ill. App. 1965); *Smith v. State*, 95 So.2d 525, 527-28 (Fla. 1957); *Palestroni v. Jacobs*, 77 A.2d 183, 184-86 (N.J. Super. 1950). All of these cases are "dictionary" cases.

[22] The court furnished the dictionary or a dictionary definition in *Dongo*, *Creasey*, *Holmes*, *Smith*, and *Palestroni*, all of which are cited in note 21, *supra*. The facts of *Holmes* are the same as those in this case. Both counsel objected. The court gave the jury the dictionary anyway. The court made no inquiry into the jury's need. The appellate court presumed prejudice and ordered a new trial. 522 P.2d at 905.

[23] It is certainly understandable that the jury asked for a dictionary. It had not been instructed on the meaning of the claims. Its request underscores the degree to which it was unguided.

the conflict created by the courts below, will enhance materially the uniformity and predictability in the law.

IV. THE CAFC'S INVOCATION OF FEDERAL CIRCUIT RULE 36 TO AVOID THE DICTIONARY ISSUE SO FAR DEPARTED FROM THE ACCEPTED AND USUAL COURSE OF JUDICIAL PROCEEDINGS AS TO CALL FOR AN EXERCISE OF THIS COURT'S POWER OF SUPERVISION

On appeal, U.S. Surgical, which had briefed the dictionary issue carefully, dwelled on it in oral argument because it was crystal clear that the only outcome under controlling Second Circuit authority, *United States v. Weiss*, *supra*, as well as other federal (and state) precedent, was for the CAFC to remand for a new trial. Yet, the panel, improperly invoking Federal Circuit Rule 36 to affirm the judgment,[24] conveniently swept a point of presumptively prejudicial error under the rug. It thereby avoided its obligation of judicial review. Such use of summary affirmance deprives a litigant of its right to meaningful appellate review. It also undermines public and party confidence in the judicial system.[25]

Summary affirmance rules like Federal Circuit Rule 36 may have a proper role, but this Court should make certain that these rules are not abused to avoid proper appellate review. The essential purpose of an appeal is to provide a litigant advancing a clear, legally-based claim with an explanation for the affirmance or reversal of that claim. Indeed, it is not too much to say

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[24] See note 17, *supra*. The dictionary issue, presently an issue of law, does not remotely come within any of the five circumstances allowing for summary affirmance. *See* App. 46a.

[25] The legal profession generally agrees "that it is important for the courts at least to issue memoranda so that they do not give the appearance to litigants of acting arbitrarily . . . ." Commission on Revision of the Federal Appellate System, Structure and Internal Procedures: Recommendations for Change, p. 49 (June 1975).

that litigants presenting such claims have a strong and legitimate expectation that they will receive written explanations in support of affirmance or reversal. *See N.L.R.B. v. Amalgamated Clothing Workers, supra,* 430 F.2d at 972-73 (Brown, C.J.).

It has been clear to the Federal Circuit Bar for some time that the CAFC has been using Federal Circuit Rule 36 to avoid its obligation of judicial review. *E.g.*, N. Dodell, *On Wanting To Know Why,* 2 Fed. Cir. Bar J. 465, 466 (1992). But the panel's invocation of Rule 36 to avoid consideration of the dictionary issue, with not only clear error but *presumptively prejudicial* error working in U.S. Surgical's favor, constitutes a unique departure from the legitimate norms of appellate decision-making. What happened below should be of gravest concern to this Court as overseer of the administration of justice in the federal court system.[26] This Court should exercise that power by granting the petition for *certiorari* and remanding to the CAFC for reconsideration of the dictionary issue in light of the presumption of prejudice as set forth in *United States v. Weiss, supra.*

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[26] It is difficult enough to provide meaningful advice to a client about a client's chances on appeal, but the task becomes impossible if a federal appellate panel may simply ignore a presumption of prejudice in favor of an appellant.

CONCLUSION

For the reasons set forth above, this Court should grant this petition for *certiorari* on the *Markman* and dictionary issues, and consolidate this case with *Markman*, whose *certiorari* petition also should be granted. If *certiorari* is denied in *Markman*, this Court should grant *certiorari* on the dictionary issue. Alternatively, if *certiorari* is denied in *Markman*, this Court should grant *certiorari* in this case and remand for reconsideration in light of the Federal Circuit's decision in *Markman*. At the same time, it should also remand for reconsideration of the dictionary issue in light of *United States v. Weiss*, *supra*.

Respectfully submitted,

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APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

94-1386, -1419

UNITED STATES SURGICAL CORPORATION,
Plaintiff-Appellant,

v.

ETHICON, INC. AND JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants/Cross-Appellants.

JUDGMENT

On Appeal from the United States District Court
for the District of Connecticut in Case Nos(s).

92-CV-134

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED. *See* Fed. Cir. R. 36.

Per Curiam (NEWMAN, *Circuit Judge*, BENNETT, *Senior Circuit Judge*, and RADER, *Circuit Judge*).

ENTERED BY ORDER OF THE COURT

/s/ Francis X. Gindhart
FRANCIS X. GINDHART
Clerk

Dated Feb. 14, 1995

APPENDIX B

[Filed Jun. 7, 1994]

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF CONNECTICUT

Civ. No. 5:92CV00134(AVC)

UNITED STATES SURGICAL CORPORATION

vs.

ETHICON, INC. and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.

RULING ON POSTTRIAL MOTIONS

This is a patent infringement action in which the plaintiff, United States Surgical Corporation (U.S. Surgical), claims that the Endoscopic Multiple Clip Applier (EMCA) and the Endoscopic Rotatable Clip Applier (ERCA) manufactured and sold by the defendants, Ethicon, Inc. and Johnson & Johnson Hospital Services (Ethicon), infringe upon claim 1 of the '420 patent [1] and claims 1, 2, and 7 of the '057 patent,[2] both owned by U.S. Surgical. On January 12, 1994, the parties tried to a jury the issue of liability. On February 16, 1994, the jury returned a verdict for Ethicon, finding: (1) that the ERCA and

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[1] Patent number 5,100,420, issued by the Patent and Trademark Office (PTO) to Green et al. (U.S. Surgical, assignee), on March 31, 1992.

[2] Patent number 5,084,057, issued by the PTO to Green et al. (U.S. Surgical, assignee) on January 8, 1992.

EMCA infringed upon claim 1 of the '420 patent, both literally and under the doctrine of equivalents; (2) that the ERCA and EMCA did not infringe upon claims 1, 2, and 7 of the '057 patent; and (3) that claim 1 of the '420 patent, as well as claims 1, 2, and 7 of the '057 patent, were invalid due to obviousness. Accordingly, on February 18, 1994, the court rendered judgment for Ethicon.

U.S. Surgical now moves for judgment notwithstanding the verdict as to the jury's finding of non-infringement of claims 1, 2 and 7 of the '057 patent and as to the jury's finding of invalidity of each of the patent claims at issue. In the alternative, U.S. Surgical moves for a new trial as to those issues, asserting: (1) that the jury's verdict was contrary to the weight of the evidence; and (2) that legal error occurred at trial to U.S. Surgical's prejudice. Ethicon moves for judgment notwithstanding the verdict as to the jury's finding of infringement of claim 1 of the '420 patent, and, in the alternative, for a new trial on that issue.

FACTS

The evidence at trial established the following facts, which are recounted in brief.

The instruments at issue in this action are endoscopic multiple clip appliers, which are used to ligate, or close, internal vessels or arteries during endoscopic surgery. Endoscopic surgery is minimally invasive surgery where doctors perform the surgical operation through small incisions, using sealed tubes, or trocars, to facilitate the entry of surgical instruments into the patient's insufflated abdomen.[3] A tiny camera can also be inserted through the trocars. Surgeons manipulate the endoscopic instru-

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[3] Insufflation is the process by which gas is pressured into the abdomen, causing the abdominal cavity to expand, thereby creating a working space for the endoscopic surgeons.

ments while monitoring their movements on a video screen.

Both U.S. Surgical and Ethicon manufacture surgical instruments, including instruments for endoscopic surgery. In 1966, U.S. Surgical received its first patents for mechanical wound closure devices.[4] By 1979, U.S. Surgical manufactured and sold automatic multiple clip appliers for use in open, or conventional, surgery.[5] Beginning in approximately 1980, Ethicon also manufactured and sold multiple clip appliers for conventional surgery. By July 1989, when U.S. Surgical applied for a patent for its endoscopic multiple clip applier, the Patent and Trademark Office (PTO) had issued at least 10 different patents for multiple clip appliers for conventional surgery. Several companies manufactured and sold approximately 40 different versions of the conventional multiple clip appliers.

As for clip appliers for use in endoscopic surgery, prior to January 1990, when U.S. Surgical introduced for commercial use its Endoclip endoscopic multiple clip applier, only single clip appliers were available for endoscopic surgery. Endoscopic single clip appliers had to be inserted and then withdrawn through a trocar in order to apply each surgical clip. By July 1989, the PTO had issued several patents for various single clip appliers for use in endoscopic surgery, and at least three different companies manufactured and sold different versions of an endoscopic single clip applier.

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[4] Begining in approximately 1966, U.S. Surgical began to manufacture and sell the first surgical clip appliers in the United States. The use of surgical clips eventually replaced, to a substantial degree, the use of sutures for ligation during surgery.

[5] In May 1979, the PTO issued to U.S. Surgical patent number 4,152,920, which disclosed a multiple clip applier for open surgery.

In mid-1987, U.S. Surgical began to develop a multiple clip applier for endoscopic surgery.[6] From approximately May 1987 through July 1989, U.S. Surgical personnel developed and tested a multiple clip applier for endoscopic surgery. On July 18, 1989, U.S. Surgical applied for a patent for its endoscopic multiple clip applier, which application ultimately resulted in the issuance of the '420 patent. On May 30, 1990, U.S. Surgical filed a further patent application, a continuation in part of the July 18, 1989 application, which ultimately resulted in the issuance of the '057 patent. In January 1990, U.S. Surgical first made the Endoclip commercially available. On January 28, 1992, the PTO issued the '057 patent. On March 31, 1992, the PTO issued the '420 patent.

Prior to 1989, the use of endoscopic surgery was largely limited to gynecological surgery, specifically, the ligation of fallopian tubes. In October 1989, at the American College of Surgeons convention, U.S. Surgical, at their convention "booth", displayed on videotape an endoscopic gallbladder removal. The endoscopic gallbladder removal demonstrated at the convention employed various U.S. Surgical endoscopic instruments, including the Endoclip. The operation also employed micro-camera technology which allowed the surgeon to monitor his movements on a video screen. From approximately October 1989 through 1993, the use of endoscopic surgery for gall bladder removals increased dramatically.[7] With the increase in

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[6] As early as 1985, U.S. Surgical personnel had discussed the development of an endoscopic multiple clip applier, but significant design and engineering work did not begin until 1987.

[7] At trial, the parties and their witnesses contested the reasons underlying the huge increase in the use of endoscopic surgery. Ethicon presented expert testimony that the "endoscopic revolution" was best attributed to the micro-camera technology which allowed the precise endoscopic procedures to be monitored by the surgeon, as first demonstrated at the October 1989 American

endoscopic surgical procedures, the U.S. Surgical Endoclip achieved considerable commercial success.

On or about May 1990, Ethicon began to develop its own endoscopic multiple clip applier. In July 1991, Ethicon made the EMCA commercially available. In October 1991, Ethicon made the ERCA commercially available. On March 10, 1992, U.S. Surgical initiated this action, alleging patent infringement, claiming that Ethicon's EMCA and ERCA infringed upon the '057 and '420 patents.

At trial, U.S. Surgical presented evidence concerning its development of its endoscopic multiple clip applier, the prosecution and granting of the '057 and '420 patents, and the success of the commercial embodiments of the U.S. Surgical invention. U.S. Surgical also presented the testimony of both a mechanical expert, Stephen Tricamo, and a patent law expert, Rene Tegtmeyer, concerning: (1) their interpretation of the patent claims at issue; (2) their conclusions that the EMCA and ERCA infringe upon the patent claims at issue, and their analysis supporting that conclusion; and (3) their conclusions that the U.S. Surgical patents were valid. Ethicon presented evidence concerning its development of the EMCA and ERCA, as well as evidence concerning prior art relevant to the field of endoscopic surgical instruments. Ethicon also presented expert testimony from a mechanical expert, Robert Mann, and a patent law expert, James Ryther, concerning: (1) their interpretation of the patent claims at issue; (2) their conclusions that the EMCA and ERCA do not infringe upon the U.S. Surgical patent claims, and their analysis supporting that conclusion; and (3) their conclusions, based on the prior art, that the U.S. Surgical patents were invalid due to obviousness.

College of Surgeons convention. U.S. Surgical, on the other hand, attributed the increase in endoscopic gallbladder removals to the availability of its endoscopic multiple clip applier.

On February 16, 1994, the jury returned its verdict for Ethicon.

STANDARD

In order to succeed on a motion for judgment notwithstanding the verdict (JNOV), the moving party must establish that the jury's findings are not supported by substantial evidence in the record. F.R.C.P. 50(a)-(b). "Substantial evidence is more than a mere scintilla. It means such evidence as a reasonable mind might accept as adequate to support a conclusion." *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 859 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 2957 (1992), *quoting Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938). Further, the court must determine whether the jury's "findings can support the legal conclusions necessarily drawn by the jury in accord with its instructions enroute to its verdict." *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984). In determining a motion for JNOV, the court must: "(1) consider all the evidence; (2) in a light most favorable to the non-mover; (3) drawing reasonable inferences favorable to the non-mover; (4) without determining credibility of witnesses; and (5) without substituting its choice for that of the jury between conflicting testimony." *Medtronic Inc. v. Intermedics, Inc.*, 799 F.2d 734, 742 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1033 (1987), *citing Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

The court, in its discretion, may grant a motion for a new trial brought pursuant to F.R.C.P. 59 if it concludes that: (1) "the verdict is against the weight of the evidence," *New Idea Farm Equip. Corp. v. Sperry Corp.*, 916 F.2d 1561, 1565 (Fed. Cir. 1990); (2) prejudicial error occurred during trial, *id.*; or (3) substantial justice has not been done, *Hugh v. Jacobs*, 961 F.2d 359, 365 (2d Cir. 1992). 11 C. Wright & A.

Miller, Federal Practice & Procedure § 2803, at 32 (1973 & Supp. 1986). "A district court ordinarily should not grant a new trial unless it is convinced that the jury reached a seriously erroneous result or that the verdict is a miscarriage of justice." *Hugh*, 961 F.2d at 365. In determining whether the verdict is against the weight of the evidence, the court "has wide discretion and may consider the credibility of witnesses and [independently] weigh the evidence." *Moxness Prods., Inc. v. Xomed, Inc.*, 891 F.2d 890, 893 (Fed. Cir. 1989).

DISCUSSION

A. Patent Infringement

In order to determine patent infringement, both literally and under the doctrine of equivalents, the court instructed the jury to compare the EMCA/ERCA with the patent claims at issue. Because the parties disputed the meaning of the patent claims and presented conflicting evidence on their proper interpretation, thereby creating "an underlying factual question," the court instructed the jury to interpret the claims "en route to deciding the issue of infringement." *Tol-o-matic v. Proma Produkt-Und Marketing*, 945 F.2d 1546, 1550 (Fed. Cir. 1991) ("The interpretation of claims is defined as a matter of law based on underlying facts.").[8] Therefore, in addition to reviewing, for substantial evidence, the jury's factual findings concerning infringement, the court, upon motion for JNOV, will review the jury's verdict "to ascertain whether reasonable jurors could have interpreted the claim[s] in such a way that supports the verdict." *Id.* (citing cases). "In moving to set aside the jury's [infringement] verdict, [the movant] must show either that the jury's findings of disputed material facts are not supported by substantial evidence, or that those findings cannot support the legal conclusions to be implied from the verdict." *Mars, Inc. v. Conlux USA Corp.*, 818 F. Supp. 707, 711 (D. Del.

[8] *See* discussion, *infra* § C.1.

1993) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984)).

Here, in their motions for JNOV, both parties challenge that portion of the jury's infringement verdict adverse to its position at trial.

1. *Infringement of Claim 1 of the '420 Patent*

Claim 1 of the '420 patent is a combination claim which describes, in pertinent part, an endoscopic clip applier which includes "a plurality of surgical clips" and a "clip closing means for sequentially closing said surgical clips," to be used in combination with a trocar, which includes a "valve means for sealing" the cannula of the trocar.

Ethicon contends that, as a matter of law, the EMCA and ERCA do not infringe upon claim 1 of the '420 patent. Ethicon argues that the Ethicon clip applier (EMCA/ERCA) and Ethicon Endopath trocar do not include every element of claim 1, because: (1) the Ethicon devices do not include the "valve means for sealing" described in the claim; and (2) the Ethicon EMCA and ERCA do not "sequentially close clips" within the meaning of the claim. Ethicon also contends that U.S. Surgical failed to prove infringement under the doctrine of equivalents.

a. *"valve means for sealing said cannula"; "said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith."*

Ethicon contends that the interpretation of the "valve means" claim limitation was not in dispute at trial, and that, "whether viewed as a means-plus-function element or a structure element," the language of the claim "as a matter of law requires the valve in the trocar cannula to

be in sealing engagement with the clip applier." [9] Ethicon argues that the Endopath trocar has both a flapper valve, which seals the cannula only when there is no instrument in the cannula, and a gasket, which seals the cannula when the EMCA/ERCA is inserted. Because the claim requires that the clip applier be "insertable through said valve means in sealing engagement therewith," Ethicon argues that its device does not infringe because the *valve* in the Ethicon trocar is never in sealing engagement with the clip applier.

U.S. Surgical, in response, asserts that Ethicon's argument—that the Endopath *valve* is not in sealing engagement with the clip applier—requires the court to ignore the actual language of the claim. The language of claim 1 requires that the clip applier be in sealing engagement with "the valve means," not the valve. U.S. Surgical contends that substantial evidence at trial supported the contention that the "valve means" claim language describes generally the structures used to prevent gas leakage while instruments are inserted or withdrawn through the trocar, not only a valve. Therefore, the "valve means" in Ethicon's trocar consist of both the flapper valve, and the gasket.

The court agrees. Substantial evidence at trial supported the conclusion that the claim language "through said valve means in sealing engagement therewith" did not require the inserted clip applier to be in sealing en-

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[9] Ethicon Memorandum in Support of Motion for JNOV, at 4. At trial, Ethicon successfully argued that the meaning of the patent claims in this action was in dispute and that the interpretation of the claims was to be submitted to the jury. In its motion for JNOV, Ethicon nonetheless contends that the meaning of certain claim language was not in dispute, and that the court was required to instruct the jury on the meaning of those terms. Ethicon did not request any such instruction to the jury on the interpretation of claims at any time prior to its motion for JNOV. The posttrial briefs in this action indicate that Ethicon's new and inconsistent position is incorrect. *See infra* § C.1.

gagement with the flipper valve in the Ethicon trocar, Rather, the clip applier, in order to infringe, must be in sealing engagement with the Ethicon trocar's "valve means," which includes both the valve and the gasket. Substantial evidence supports the jury's conclusion that the Ethicon trocar and EMCA/ERCA infringed the "valve means" claim element.

b. *"an endoscopic clip applier having" "clip closing means for sequentially closing [a plurality of] surgical clips"*

Although Ethicon requested at trial that the court submit to the jury the issue of claim interpretation, it now asserts that, as a matter of law, the "means for sequentially closing" clips must be construed to incorporate the clip advancing means disclosed in U.S. Surgical's patent specifications. Unlike the other patent claims at issue, claim 1 of the '420 patent does not include any claim limitation concerning the means for advancing surgical clips through the endoscopic shaft to the jaws which fasten the clips.[10] Rather, claim 1 of the '420 patent describes the combination of a trocar and an endoscopic clip applier that includes: (1) a frame; (2) a plurality of surgical clips disposed in any array and clip closing means for sequentially closing clips; and (3) a seal means. Ethicon argues that the clip advancing means described elsewhere in the '420 patent must be implied

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[10] Each of claims 1, 2 and 7 of the '057 patent include claim limitations concerning the means for advancing surgical clips. *See* claim 1, '057 patent ("(b)(ii) means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped"); claim 2 (dependent claim which incorporates the limitations of claim 1, above); claim 7 ("(b)(iii) means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped"). Accordingly, the jury found infringement of claim 1 of the '420 patent, but non-infringement as to each claim of the '057 patent.

as a claim limitation inherent in claim 1.[11] Implying that the clip advancing means is a limitation to claim 1, Ethicon contends that the advancing means in the EMCA/ERCA are not the equivalent of the advancing means disclosed in the specifications of the '420 patent. Ethicon further asserts that the clip closing means—or "jaws"—in the EMCA/ERCA are not the equivalent of the jaws disclosed in the '420 patent.[12]

U.S. Surgical, in response, contends that substantial evidence supported the jury's conclusion that the clip advancing means of the patented device were not an inherent claim limitation of claim 1 of the '420 patent, notwithstanding the use of the word "sequentially" in the patent claim. Further, U.S. Surgical argues that substantial evidence supported the jury's conclusion that the jaws of the ERCA/EMCA are equivalent in structure to the jaws disclosed in the '420 specification.

The court concludes that substantial evidence supported both the jury's interpretation of this claim element and the jury's conclusion that the EMCA/ERCA infringed upon this claim element. The jury's finding, implicit in its

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[11] Ethicon argues that the clip advancing means is implied in claim 1 because: (1) a clip advancing structure is necessary in order to fulfill the essential function of the instrument described—to place numerous surgical clips during a single entry through a cannula; and (2) the use of the word "sequentially" in claim 1 references the "sequence" described throughout the '420 patent and the '057 patent, such sequence including the advancement of clips into the jaws of the clip applier.

[12] In support of its contention that the EMCA/ERCA does not satisfy the claim limitations of this claim element, Ethicon also asserts: (1) that the EMCA/ERCA does not perform the disclosed function of "sequentially closing" multiple clips, because the word "sequential" implicitly requires semi-automatic operation as a claim limitation; and (2) that the "issuance of Ethicon's '247 and '249 patents in and of itself requires a finding of non-infringement of the clip closing means." The court concludes that these grounds for JNOV lack merit.

verdict on infringement, that claim 1 of the '420 patent did not include clip advancing means, is supported by substantial evidence. U.S. Surgical presented substantial evidence concerning the patent's prosecution history, as well as expert testimony, that support the jury's interpretation of "clip closing means." The court concludes that the jury correctly interpreted this claim, so as not to include "clip advancing means" as an implicit limitation of claim 1. Accordingly, the determination of infringement of claim 1 does not require a finding that the EMCA/ERCA's clip advancing means were equivalent to those discolsed in the '420 patent.

The court further concludes that substantial evidence supported the jury's finding that the EMCA/ERCA jaws were equivalent to the jaws disclosed in the '420 patent specification. The evidence established that the Ethicon jaws were narrower so as to fit through a cannula without closing. The fact that the Ethicon jaws performed slightly differently, or performed an additional function (insertion without closing), does not negate infringement of the patented claim. *See, e.g., Texas Instruments v. U.S. Intern. Trade Com'n,* 805 F.2d 1558, 1563-64 (Fed. Cir. 1986); *Amstar Corp. v. Envirotech Corp.,* 730 F.2d 1476, 1482 (Fed. Cir.) (quoting *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F.2d 381, 402 (10th Cir. 1965), *cert. denied,* 383 U.S. 933 (1966)) ("infringement cannot be avoided by the mere fact that the accused device is more or less efficient or performs additional functions"), *cert. denied,* 469 U.S. 924 (1984).

c. *Infringement under the Doctrine of Equivalents*

Ethicon also moves for JNOV concerning the jury's verdict of infringement under the doctrine of equivalents. As to claim 1 of the '420 patent, the jury found that the Ethicon EMCA/ERCA and Endopath trocar performed the same function, in the same way, and to

achieve the same result, as the invention in claim 1 of the '420 patent.

Ethicon first contends that, as a matter of law, the court should not have allowed the jury to consider the issue of infringement under the doctrine of equivalents. As it did at trial, Ethicon argues that the "application [of the doctrine of equivalents] was not appropriate unless the court made a threshold finding that Ethicon copied or stole the patented invention or otherwise perpetrated a fraud on the patent." The cases upon which Ethicon relies do not support the rule proposed.[13] Al-

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[13] The Federal Circuit cases cited by Ethicon do not support the proposition that the trial court must make a threshold determination of copying or misappropriation before submitting the doctrine of equivalents to the jury, or before entering a judgment under the doctrine of equivalents. In *Charles Greiner & Co. v. Mari-Med Mfg. Inc.*, 962 F.2d 1031, 1035-37 (Fed. Cir. 1992), the Federal Circuit discussed the equitable origin of the doctrine of equivalents, which is designed to prevent "fraud on the patent," and also stated that the doctrine must not be applied in a way that ignores the legal significance of claim limitations. In *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991), the court, in affirming the district court's summary judgment ruling, stated that the doctrine of equivalents should not operate to expand the protective scope of patent claims. The court also noted that the doctrine is designed to prevent infringers who "merely make[] an insubstantial change [to a patented device]." *Id.* In *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993), which also did not involve a jury trial, the court stated: "[T]he Supreme Court refused to allow an 'unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim.' (citing *Graver Tank*, 339 U.S. at 607 (1950)). This statement elucidates both the purpose of the doctrine and the type of conduct which triggers its application. An equivalent under the doctrine of equivalents results from an insubstantial change which, from the perspective of one of ordinary skill in the art, adds nothing of significance to the claimed invention." Here, the court concluded that the evidence in this case sufficiently "triggered" the doctrine of equivalents, and instructed the jury on both the purpose of the doctrine and how to apply it.

though the doctrine of equivalents should not be "simply the second prong of every infringement charge," *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1036 (Fed. Cir. 1992), quoting *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed Cir. 1991), it should be applied to ensure that one does not avoid infringement by making only "an insubstantial change which, from the perspective of one of ordinary skill in the art, adds nothing of significance to the claimed inventoin." *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993). The jury properly considered infringement under the doctrine of equivalents in this case.

Ethicon contends that the sealing structures in its trocar—the valve and gasket—perform a function different from the patented invention, and do so in a different way. Ethicon argues that the jury could only conclude that its valve and gasket was a substantially equivalent "valve means" if it ignored the claim limitation, i.e., "*valve* means." Further, Ethicon asserts that U.S. Surgical failed to adduce evidence to support a particularized showing as to "how" and "why" the Ethicon devices performed in a substantially similar "way" as the patented invention.

For the reasons discussed above, *supra* § A.1.a, the court rejects Ethicon's contention that the Ethicon valve and gasket perform a substantially different function, in a different way, than the "valve means" described in claim 1. Further, the record discloses that U.S. Surgical adduced substantial evidence at trial concerning how and why the Ethicon devices performed in the same way as the patented invention. It was proper for certain witnesses to explain how the "way" prong of the doctrine of equivalents was satisfied by referring to earlier testimony pertaining to literal infringement analyses, provided that there was "testimony explicitly comparing the claimed and accused devices as to all three elements of equivalents." *Lear Siegler, Inc. v. Sealy Mattress Co.*

of Mich., 873 F.2d 1422, 1426 (Fed. Cir. 1989) (party asserting infringement must present evidence and argument concerning the doctrine and each of its elements).

Accordingly, the court concludes that substantial evidence supported the jury's conclusion that claim 1 of the '420 patent was infringed under the doctrine of equivalents. Further, "in the interest of judicial economy and conservation of the parties' resources," the court will permit the jury's verdicts of both literal infringement and infringement under the doctrine of equivalents to stand pending appeal. *See, e.g., Goodwall Constr. Co. v. Beers Constr. Co.*, 991 F.2d 751, 754 (Fed. Cir. 1993).

Because the record provides substantial support for the jury's finding of infringement of Claim 1 of the '420 patent, both literally and pursuant to the doctrine of equivalents, as discussed above, the court denies Ethicon's motion for JNOV. The court also denies Ethicon's motion for a new trial on the issue of infringement of claim 1 of the '420 patent.

2. *Verdict of Non-infringement of Claims 1, 2, and 7 of the '057 patent*

U.S. Surgical moves for JNOV, or in the alternative, for a new trial, as to the jury's verdict that claims 1, 2, and 7 of the '057 patent were not infringed.

Claims 1, 2, and 7 of the '057 patent each disclose an endoscopic multiple clip applier. As discussed above, claims 1, 2, and 7 of the '057 patent each contain at least one critical claim element which is not contained in claim 1 of the '420 patent. Each claim includes a means-plus-function claim element concerning the means for individually advancing multiple surgical clips through the endoscopic section of the clip applier and into a pair of jaws at the end of the instrument.[14] Because of these

[14] Specifically, claim 1 of the '057 patent discloses an endoscopic multiple clip applier, that includes: "ii) means for individually

clip-advancing claim elements, in order for the jury to conclude that claims 1, 2, and 7 were infringed, it had to find that: (1) the EMCA/ERCA performs the identical function called for by the claim element (individually advancing clips into the jaws); *and* (2) the structures which perform that function in the EMCA/ERCA are identical to, or the equivalent of, the structures described in the U.S. Surgical patent specifications to perform that function. 35 U.S.C. § 112; *Valmont Indust.*, 983 F.2d at 1042.

Both U.S. Surgical and Ethicon presented considerable evidence concerning the strictures disclosed in the U.S. Surgical patents that performed the clip advancing function, and whether the clip advancing structures in the ERCA/EMCA constituted "the equivalent" of those structures.[15] Substantial evidence in the record supports the jury's finding that the EMCA/ERCA's clip advancing structures were not the equivalent of the structures dis-

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advancing [multiple] clips to the distal portion of said endoscopic means for positioning adjacent to the body tissue to be clipped;" and "iii) means for at least partially closing each said clip at least sufficient to grip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means." Claim 2 is a dependent claim, which incorporates all of the claim elements of claim 1, including those quoted above. Claim 7 discloses a disposable endoscopic multiple clip applier, that includes: "iii) means for individually advancing [multiple] clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped;" and "iv) means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue."

[15] For example, Ethicon's witnesses contended that its "fully "semi-automatic" structures disclosed in U.S. Surgical's patents automatic" clip advancing structures were not the equivalent of the specifications. U.S. Surgical's witnesses disagreed. Ethicon's witnesses contended that the EMCA/ERCA clip advancing means, which included a "feed bar, two plane clip track, lifter spring, and escapement" were not the equivalent of the one plane pusher bar disclosed in the U.S. Surgical patent. U.S. Surgical's witnesses disagreed.

closed in the U.S. Surgical patents to perform the function of advancing clips.[16] Accordingly, U.S. Surgical's motion for JNOV as to infringement of claims 1, 2, and 7 of the '057 patent, both literally and under the doctrine of equivalents, is denied. The court also denies U.S. Surgical's motion for a new trial on this issue.

B. Patent Invalidity

Pursuant to 35 U.S.C. § 103, an "obvious" patent claim is invalid and unenforceable. A patent claim is obvious if "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. The determination of obviousness is classified as a legal conclusion that relies on a number of "factual underpinnings," [17] namely: (1) invention; (2) the differences between the prior art and the patent claims at issue; and (3) the level of ordinary skill in the art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "Secondary considerations," including commercial success, long-felt but unsolved need, and failure to others to attain the invention, may also be relevant to the obviousness determination. *Id.* at 17-18. When the "factual underpinnings" are in dispute, as in this action, the issue of obviousness is properly submitted to the jury. *E.g.*, *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993).

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[16] This finding alone mandates a verdict of non-infringement. The court does not address other methods by which the jury could have determined the non-infringement of claims 1, 2, and 7 of the '057 patent.

[17] *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993); *See also Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (referring to obviousness as a question of law based upon "several basic factual inquiries").

Here, the jury considered the differences between the prior art and the patent claim and concluded that the subject matter of the patent claim would have been obvious to a person of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103. The court reviews the jury's finding of obviousness to determine whether the factual findings implicit in the jury's verdict are supported by substantial evidence. *E.g., Jurgens v. McKasy*, 927 F.2d 1552, 1558 (Fed. Cir.), *cert. denied*, 112 S. Ct. 281 (1991) ("When the *Graham* factual underpinnings have been genuinely disputed . . . we presume that the jury resolved them in favor of th everdict winner."); *see also Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) ("Judges must accept the factual findings, presumed from a favorable jury verdict, wihch are supported under a substantial evidence/reasonable juror standard."), *cert. denied*, 493 U.S. 814 (1989)."

1. *Invalidity of Claim 1 of the '420 patent*

U.S. Surgical correctly asserts that in order for the jury to find that claim 1 of the '420 patent, a combination patent claim, was obvious, the jury had to find: (1) that the prior art would have taught or suggested, to the person of ordinary skill, the combination of individual elements found in the patented device, *e.g., Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 297 & n. 24 (Fed. Cir. 1985) (where party asserting invalidity relies on combination of prior art references, it must show teaching or suggestion in those references which support their use in combination), *cert. denied*, 475 U.S. 1017 (1986); and (2) that the prior art would sufficiently teach or direct one of ordinary

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[18] In reviewing the obviousness verdict, the court does not "lose sight of the presumption of [patent] validity," *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893 (Fed. Cir. 1984), and takes into account the clear and convincing standard of proof required to prove obviousness. *Id.*

skill "how to obtain the desired result." *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990); *See Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724-25 (Fed. Cir. 1990). U.S. Surgical argues that Ethicon failed to adduce substantial evidence to support, by clear and convincing evidence, the jury's findings: (1) that the prior art taught or suggested the desirability of the U.S. Surgical invention; or (2) that the prior art would teach one of ordinary skill how to obtain the claimed invention. U.S. Surgical contends, as to these requirements, that Ethicon relied on only four pieces of prior art—the Green '226 patent, the Polk '239 patent, Yoon's 1987 abandoned patent application, and the Bonnet '965 patent—and that this prior art did not constitute substantial evidence.

Ethicon, in response, asserts that in order to prove obviousness, it relied on a large number of prior art references, particularly the large body of prior art concerning multiple clip appliers for conventional surgery and clip appliers. Ethicon argues that the only difference between the U.S. Surgical invention and the multiple clip appliers in the prior art was the invention's longer shaft and seal. These attributes, Ethicon argues, were obviously necessary for any endoscopic instrument, as demonstrated by the prior art in the endoscopic field. Further, Ethicon contends that it adduced substantial evidence in supoprt of the specific finding that the prior art taught or suggested the desirability of the claimed invention, *and* how to obtain it.

Evidence at trial established that the field of multiple clip appliers for conventional surgery was a highly developed and crowded field of art at the time of U.S. Surgical's invention. By 1989, numerous companies manufactured and sold approximately forty different multiple clip appliers for open surgery. Several of the multiple clip appliers in the prior art included many of the same general features of the U.S. Surgical invention, i.e., a

frame, a shaft, camming jaws, bias spring, pusher bar, and escapements.[19] Although this multiple clip applier prior art did not contain the mechanical qualities necessary for endoscopic instruments, the prior art also included a variety of endoscopic instruments, including endoscopic single clip appliers. Ethicon adduced evidence at trial that the only difference between the multiple clip applier prior art and the invention was that the invention was sealed and had a longer shaft. Ethicon argued that this difference made the invention obvious because the incorporation of a longer shaft and seal into the conventional multiple clip applier technology was obvious, considering the prior art in endoscopy. Ethicon's experts also testified that the prior art would have given a person of ordinary skill in the art a suggestion, incentive, or motivation to make the claimed invention.[20]

The jury concluded that, given the difference between the prior art and the invention, the invention would have been obvious to the person of ordinary skill in the field; that the prior art taught or suggested the combination of elements found in the invention;[21] and that the prior art also provided sufficient instruction how to obtain the invention.[22] These conclusions, the "factual underpinnings"

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[19] Prior art conventional clip appliers with these features included the Premium Surgiclip, disclosed in the Green '226 patent, and the Davis & Geck Multiclip, disclosed in the Montgomery '373 patent.

[20] *E.g.*, Transcript at 2238, 2332-33.

[21] U.S. Surgical "has not shown that reasonable jurors could not agree with [Ethicon's experts]" as to the prior art teaching the desirability of the invention. *See Bio-rad Laboratories v. Nicolet Instrument Corp.*, 739 F.2d 604, 611 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984).

[22] As to the requirement that the prior art provide a skilled person a "reasonable expectation of success" in obtaining the invention, the prior art evidence concerning multiple clip appliers and endoscopic instruments, and the testimony of inventors and experts concerning what that prior art taught as to how to build

of the determination of obviousness, are factual findings, *see Bio-rad Laboratories v. Nicolet Instrument Corp.*, 739 F.2d 604, 611 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984), which the court will not upset unless a reasonable jurior could not have so found. *Newell Cos.*, 864 F.2d at 765.[23] The court concludes that substantial evidence in the record supported the jury's factual findings in support of its verdict on obviousness. Accordingly, the motion for JNOV as to the obviousness of claim 1 of the '420 patent is denied. The court also denies U.S. Surgical's motion for a new trial on this issue.

2. *Invalidity of Claims 1, 2, and 7 of the '057 patent*

U.S. Surgical moves for JNOV, or, in the alternative, for a new trial as to the jury's conclusion that claims 1, 2, and 7 of the '057 patent, which were found not to be infringed by the EMCA/ERCA, were obvious. U.S. Surgical asserts that the jury's verdict as to these claims, i.e., noninfringement coupled with invalidity, is inconsistent, and a result that was not advocated by either party nor supported by sufficient evidence.[24]

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an endoscopic multiple clip applier, constitutes substantial evidence to support the jury's finding.

[23] In *Bio-rad Laboratories*, the court explained the role of the jury in determining obviousness: "This excerpt from [expert] testimony . . . illustrate[s] the importance of the jury's role in ascertaining the content of the prior art. The jurors must discern how a person of ordinary skill in the art would have interpreted available art at the time the invention was made. The factfinder's interpretation of prior art references is necessarily guided by the credibility given the testimony of experts." *Bio-rad Laboratories* 739 F.2d at 611.

[24] Ethicon's contention that U.S. Surgical waived its right to move for JNOV as to infringement of their patents by failing to move for a directed verdict at the close of the case lacks merit. On February 9, 1994, U.S. Surgical filed a written motion for

In *Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967 (1993), the Supreme Court recognized that the infringement and validity inquiries are independent:

> [O]ur prior cases have identified a strong public interest in the finality of judgments in patent litigation. . . [W]e approved of the District Court's decision to consider the question of validity even though it had found that a patent had not been infringed. . . . [W]e stated that "of the two questions, validity has the greater public importance, . . . and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

Id. at 1977 (citations omitted) (overruling Federal Circuit's practice of routinely vacating judgments of validity after finding noninfringement). Accordingly, in this case the court instructed the jury to determine patent validity even if it found noninfringement. The jury was not required to adopt entirely the position of one party or the other, or accept the entire testimony of a given expert. Upon motion for JNOV, "[w]here there is a view of the case that makes the juries answers to special interrogatories consistent, they must be resolved that way." *Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1563 (Fed. Cir.), *cert. denied*, 488 U.S. 850 (1988).[25] Here, the court concludes that the jury's conclusions as to infringement and validity can be harmonized with the evidence presented, and that substantial evidence in the record supports the court's conclusion of invalidity of claims 1, 2, and 7 of the '057 patent.

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judgment as a matter of law on the issues of infringement and validity.

[25] The Second Circuit has stated: "A district court has a duty to reconcile the jury's answers on a special verdict form with any reasonable theory consistent with the evidence, and to attempt to harmonize the answers if possible under a fair reading of those answers." *McGuire v. Russell Miller, Inc.*, 1 F.3d 1306, 1311 (2d Cir. 1993).

Accordingly, the motion for JNOV as to the validity of claims 1, 2 and 7 of the '057 patent is denied. The court also denies the motion for a new trial on this issue.

C. Motions for New Trial

1. *Interpretation of Claims by the Jury*

At trial, U.S. Surgical urged the court to instruct the jury on the meaning of the four patent claims at issue.[26] Ethicon, in response, argued that, because the parties intensely disputed the meaning of the claims and because the parties presented conflicting extrinsic evidence concerning the meaning of the claim, the court should submit the issue of claim interpretation to the jury to decide in its determination of infringement. The court instructed the jury to determine the meaning of the patent claims. U.S. Surgical now claims that the court's failure to instruct the jury on the meaning of each patent claim at issue constitutes error which requires a new trial.

U.S. Surgical asserts that the construction of patent claims is an issue of law, which the court may submit to the jury only where a "disputed issue of fact" arises in connection with the interpretation of a term in a claim. Notwithstanding the diametrically opposed testimony of the parties' mechanical experts and legal experts as to the meaning of the U.S. Surgical patent claims, U.S. Surgical contends that no factual dispute existed as to the meaning of the patent claims in this action.

The Federal Circuit, on numerous occasions, has stated that, "[c]laim interpretation is a question of law for the court." *Read v. Portec Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1922); *Associated Equipment Corp. v. Authorized Motor Parts Corp.*, 27 U.S.P.Q.2d 1784, 1785 (Fed. Cir. 1993); *Structural Rubber Prods. v. Park Rubber*

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[26] U.S. Surgical submitted to the court not less than 30 pages of proposed jury instructions concerning the meaning of the U.S. Surgical patent claims at issue.

Co., 749 F.2d 707, 721 (Fed. Cir. 1984). However, a similarly long line of Federal Circuit cases maintains that: "[W]hen the meaning of a term in the claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying fact question arises, and the construction of the claim should be left to the jury under appropriate instruction." *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985).[27] In *Tol-o-matic v. Proma Produkt-Und Marketing*, 945 F.2d 1546, 1550 (Fed. Cir. 1991), the Federal Circuit described the "underlying factual questions" that the jury should consider when the meaning of patent claim terms is unclear: "the description of the claimed element in the specification,

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[27] *See Associated Equipment*, 27 U.S.P.Q.2d at 1786 ("In a jury trial, it is the jury's province to find the facts. Thus, in cases where factual disputes underlie the ultimate legal question of claim interpretation, the issue of claim interpretation must be submitted to the jury for its decision once it finds the underlying facts."); *Drexelbrook Controls, Inc. v. Endress & Hauser, Inc.*, 1993 U.S. App. LEXIS 1915, at *4 (Fed. Cir. 1993) ("Although claim interpretation is a question of law, . . . where the claim terms in issue involve complex scientific principles and conflicting expert testimony, an underlying question of fact is created."); *Lemelson v. General Mills*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992) ("[T]he determination of the scope of the claim—its interpretation and proper construction—while denominated a question of law is in many cases based on the facts . . . . The underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement."), *cert. denied*, 113 S.Ct. 976 (1993); *Tol-o-matic v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991) ("When the meaning of a term in a patent claim is unclear, the jury may interpret the term en route to deciding the issue of infringement."); *Snellman v. Ricoh Co., Ltd.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988) (upholding the jury's apparent claim interpretation in view of expert testimony and the language of the specification), *cert. denied*, 491 U.S. 910 (1989); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.) ("[If] the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, the construction of claims could be left to a jury [and] the jury cannot be directed to the disputed meaning for the term . . . ."), *cert. denied*, 469 U.S. 1037 (1984).

the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." Here the court determined that a genuine dispute of fact existed as to these questions, and as to how one skilled in the art would construe the U.S. Surgical patent claims,[28] as demonstrated by conflicting expert testimony on the issue. Pursuant to Federal Circuit precedent, the court submitted claim construction to the jury for its determination "en route to deciding the issue of infringement." *Id.* at 1550. Accordingly, the court denies U.S. Surgical's motion for a new trial on this ground.[29]

2. *Exclusion of Evidence of Ethicon's Patents*

As grounds for a new trial on the issue of infringement, Ethicon contends that the court erred in excluding evidence concerning Ethicon's '247 and '249 patents, which the PTO granted to Ethicon for the ERCA and EMCA.[30] Ethicon asserts that its patents on the accused devices are powerful evidence of non-infringement,

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[28] Patent claims should be construed as one skilled in the art would construe the claims. *E.g., Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986).

[29] U.S. Surgical also contends that the court erred when it: (1) failed to instruct the jury as U.S. Surgical requested concerning (a) the absence of secondary considerations, (b) the significance of prior art references that teach away from the claimed invention, and (c) "equivalents" under 35 U.S.C. § 112; and (2) when it permitted certain evidence and did not instruct the jury as requested by U.S. Surgical concerning (a) the manner in which the invention was made; (b) the market effects of injunctive relief; (c) the significance of cumulative prior art references. The court concludes that these claims are without merit, and denies U.S. Surgical's motion for a new trial on these grounds.

[30] Prior to trial the court granted U.S. Surgical's motion in limine to exclude evidence and argument concerning Ethicon's patents on the accused devices. The court denied Ethicon's January 6, 1994, motion to reconsider the court's ruling. The court also

and that the court's evidentiary ruling constitutes prejudicial error. Further, in its argument for JNOV as to the infringement of claim 1 of the '420 patent, Ethicon asserts that "the issuance of Ethicon's '247 and '249 patents in and of itself requires a finding of non-infringement [as to] the 'clip closing means' " claim element.

In *Atlas Powder v. E.I. DuPont De Nemours,* 750 F.2d 1569 (Fed. Cir. 1984), the Federal Circuit established that the receipt of a patent on an accused device does not negate infringement:

> [W]here defendant has appropriated the material features of the patent in suit, infringement will be found "even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement." (quoting *Bendix Corp. v. United States,* 199 U.S.P.Q. 203 (Ct. Cl. Trail Div. 1978)). . . .
>
> . . . .
>
> "Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the conclusion. In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay any attention thereto. . . . Patentable difference does not of itself tend to negative infringement." (quoting *Herman v. Youngstown Car Mfg. Co.,* 191 F. 579, 584-85 (6th Cir. 1911)).

Id. at 1580-81.[31] *See also Chemical Eng. Corp. v. Essef*

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denied Ethicon's proposed jury instruction, which would have informed the jury of Ethicon's patents on the accused devices and instructed the jury as to how to consider the evidence.

[31] Ethicon argues that the Federal Circuit's ruling in *Atlas Powder* concerning the relevance of subsequent patents on the accused device does not apply in cases involving means-plus- func-

Indus., Inc., 795 F.2d 1565, 1569 & n. 6 (Fed. Cir. 1986) (patent on accused device "utterly irrelevant to infringement"); *King Instr. Corp. v. Otari Corp.*, 767 F.2d 853, 867 (Fed. Cir. 1985) (patent on accused device is "irrelevant in infringement analysis"), *cert. denied*, 475 U.S. 1016 (1986).

However, Ethicon asserts that the Federal Circuit's decision in *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948 (Fed. Cir. 1993), required the court to admit evidence of Ethicon's patents on its accused devices. In *Hoganas*, the Federal Circuit affirmed the court's summary judgment ruling of non-infringement of the plaintiff's patent claims, both literally and under the doctrine of equivalents. *After* concluding that the district court correctly granted summary judgment, the Federal Circuit stated:

> In support of our conclusion, we note that the PTO granted [the defendant] a patent [on the accused product] with the knowledge of the]plaintiff's[patent, which is listed as art of record. Thus, the PTO must have considered the accused product to be nonobvious with respect to the patented composition.

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tion claims, and that evidence of patents can be excluded only in cases concerning structure patent claims. However, courts have applied this rule of relevance to means-plus-function claims. *See, e.g., Texas Instruments*, 805 F.2d at 1563-64; *Pfaff v. Wells Electronics, Inc.*, 9 U.S.P.Q.2d 1366, 1368 (N.D. Ind. 1988); *Rite-Hite Corp. v. Kelley Co.*, 629 F. Supp. 1042, 1056 (E.D. Wis. 1986); *Bendix Corp. v. United States*, 199 U.S.P.Q. 203, 221-222, 224 (Ct. Cl. 1978). The court disagrees with Ethicon's assertion that the PTO's analysis—determining whether a given structure in Ethicon's device is patentable (novel and nonobvious) after considering the structures specified in U.S. Surgical's patents, which were prior art—is identical to the jury's infringement analysis of means-plus-function claims, i.e., determining whether the EMCA/ERCA's structures to perform a certain function are the substantial equivalent of the structures disclosed in the U.S. Surgical patents to perform a certain function. *See Atlas Powder*, 750 F.2d at 1581.

> Accordingly, the issuance of that patent is relevant to the equivalence issue.

Id. at 954. *Hoganas* established that patents on an accused device *can* be relevant to the infringement analysis. *Id. Hoganas* did not establish that such patents must always be admitted into evidence, and that failure to do so constitutes prejudicial error.[32] Here, the court excluded the evidence of Ethicon's '247 and '249 patents based not only on their limited relevance, but because the probative value of the evidence was substantially outweighed by the danger of unfair prejudice, confusion of the issues, and misleading the jury. Fed. R. Evid. 403. Because a jury could be easily misled by the evidence of Ethicon's patents, or fail to comprehend the proper limited role of such evidence in the infringement analysis, the Federal Circuit has affirmed the practice of excluding such evidence. *See Glaros v. H.H. Robertson Co.*, 230 U.S.P.Q. 393, 398 (Fed. Cir. 1986) (affirmed excluding patent on accused device because it "would have injected frolics and detours" and was "likely to create side issues that would have unduly distracted the jury from the main issues"); *see also Blanchard v. Putnam*, 75 U.S. 420, 425-26 (1869); *Union Carbide Corp. v. Tarancon Corp.*, 742 F. Supp. 1565, 1577 (N.D. Ga. 1990) ("most lay people believe that once they receive a patent, their invention has been held unique *and* non-infringing") (emphasis in original); *Crown Cork & Seal Co. v. Ethyl Corp.*, 11 U.S.P.Q.2d 1577, 1580 (E.D. Va. 1989); *Padco, Inc. v. Newell Cos. Inc.*, 13 U.S.P.Q.2d 1607, 1611, 1613 (E.D. Wis. 1989).

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[32] In *Hoganas*, the Federal Circuit reviewed the court's ruling granting summary judgment, not an evidentiary ruling in a jury trial concerning the admission into evidence of the defendant's patents. In contrast to a jury trial, it is unlikely that the court would attach improper legal significance to the defendant's patents, or that the court would be confused by such evidence.

Accordingly, the court denies Ethicon's motion for a new trial on this ground.[33]

3. *The Dictionary*

On the first day of the jury's three day deliberations, the jury requested a dictionary. Early in the second day of the deliberations, the court provided to the jury *Webster's New World Dictionary*. U.S. Surgical argues that it is entitled to a new trial because the court erred in providing a dictionary to the jury during its deliberations.

The court instructed the jury as to the legal definitions of important terms in this action such as "obviousness" and "infringement." Further, the court instructed the jury that the court's instructions on the law were to govern their deliberations, and that they were not to stray from the legal principles contained in the instructions. *See DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 425 (Fed. Cir. 1986) (the law presumes that the jury followed the court's instructions and found all facts necessary for the verdict). In its jury instructions concerning the interpretation of patent claims, the court also instructed the jury that it should consider, among other factors, "the ordinary meaning of the language used in the claim." Charge to the Jury, at 13. Because the jury was properly instructed to consider the "ordinary meaning" of the terms used in the patent claims, the court concludes that the court correctly provided the jury with a dictionary upon their request. *See State v. Asherman*, 193 Conn. 695 (1984) ("the definition of words in our standard dic-

[33] Ethicon also moves for a new trial on the grounds that the court erred in its instructions to the jury concerning the doctrine of equivalents. The court concludes that the motion lacks merit, and, therefore, denies the motion. Ethicon also moves for a trial on the issue of inequitable conduct, should the court grant U.S. Surgical's motion for JNOV, or order a new trial on any issue. Because the court has not so ordered, the motion is denied as moot.

tionaries is taken as a matter of common knowledge which the jury is supposed to possess"). Further, U.S. Surgical has not established that the provision of the dictionary resulted in prejudice. *Cf. United States v. Steele*, 785 F.2d 743, 748 (9th Cir. 1986) (irrelevant that dictionary definition of "infringement" may have differed from the legal definition set forth in the charge, absent evidence that the jury actually disregarded the court's instruction).

Accordingly, the court denies U.S. Surgical's motion for a new trial on this ground.

CONCLUSION

For the reasons contained herein, U.S. Surgical's motions for JNOV and for a new trial (documents no. 454 and 456) are denied, and Ethicon's motions for JNOV and for a new trial (document no. 459) are denied.

It is so ordered, this 7th day of June, 1994, at Hartford, Connecticut.

/s/ Alfred V. Covello
ALFRED V. COVELLO
United States District Judge

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

94-1386, -1419

UNITED STATES SURGICAL CORPORATION,
Plaintiff-Appellant,

v.

ETHICON, INC and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants/Cross-Appellants.

ORDER

A combined petition for rehearing and suggestion for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on March 30, 1995, unless another timely petition for rehearing is filed within the time permitted by Rule 40.

FOR THE COURT
FRANCIS X. GINDHART
Clerk

By /s/ Diane M. Frye
DIANE M. FRYE
Chief Deputy Clerk

Dated: March 23, 1995

APPENDIX D

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

592CV134 (WWE)
March 5, 1993

UNITED STATES SURGICAL CORPORATION,
Plaintiff,

v.

ETHICON, INC and JOHNSON & JOHNSON
HOSPITAL SERVICES, INC.,
Defendants.

RECOMMENDED RULING ON PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT ON THE ISSUE OF INFRINGEMENT OF CLAIM 1 OF U.S. PATENT NO. 5,100,420

Introduction

Plaintiff, United States Surgical Corporation ("USSC") has moved for summary judgment (Docket Entry No. 240) that the defendants', Ethicon, Inc., and Johnson & Johnson Hospital Services, Inc., (collectively "J&J") endoscopic multiple clip applier, known as the "EMCA", and a rotatable version thereof, known as the "ERCA", infringe claim 1 of U.S. Patent 5,100,420 (hereinafter the '420 Patent).

In support of its motion, plaintiff contends that there are no material facts in issue as to the scope of claim 1 and that the accused EMCA and ERCA devices fall within the metes and bounds theerof. Defendants vig-

orously dispute these assertions and contend that the interpretation of claim 1 raises certain underlying factual issues necessitating consideration of extrinsic evidence to resolve. Further, defendants contend that if claim 1 is interpreted not to literally read on the accused devices, there is a factual issue for the jury, as to whether the accused devices perform substantially the same function, in substantially the same way, to achieve substantially the same results, under the doctrine of equivalents used to determine infringement in patent cases.

For the reasons set forth below, a threshold factual issue underlying the interpretation of the scope of claim 1 of the '420 Patent exists which must be resolved with the aid of extrinsic evidence before infringement can be determined. Accordingly, USSC's Motion for Summary Judgment on the Issue of Infringement of Claim 1 of the '420 Patent will be denied.

The Underlying Factual Dispute

Claim 1 of the '420 Patent covers an endoscopic multiple clip applier used in combination with a trocar having a cannula, and a valve means for sealing the cannula. The means portions of the claim that are in dispute are the means for sequentially closing a plurality of surgical clips as they are applied to, for example, a blood vessel in the body, and the valve means between the trocar and cannula sealing the cannula to prevent the escape of gas from the body cavity in which the clip applier is inserted during the surgical procedure.

Claim 1 of the '420 Patent reads as follows:

> "1. In combination:
>
> a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity;
>
> b) an endoscopic clip applier having:

i) a frame;

ii) an endoscopic portion defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith, said endoscopic portion further including a plurality of surgical clips disposed in an array and *clip closing means for sequentially closing said surgical clips*; and

iii) *seal means* associated and *adapted to cooperate with at least one of said endoscopic portion and said frame* to obstruct passage of gaseous media from the body cavity." (emphasis added).

In its moving papers, USSC admits that a "dispute . . . exists between the parties . . . around the phrase 'clip closing means for sequentially closing the surgical clips' contained in Section b) ii)." (USSC Memorandum of Points and Authorities, p. 2).

The invention as defined by claim 1 relates to a device for applying surgical clips in endoscopic procedures. Endoscopic surgery is performed through narrow tubes inserted through small entrance wounds in the skin. Endoscopic procedures generally require that any instrumentation inserted into the body be sealed, i.e., provisions must be made to ensure that gases do not enter or exit the body through the endoscopic incision as, for example, in surgical procedures in which the patient is insufflated. The clip applying apparatus includes the mechanism for introducing the clip through the sealed tube of the device into the body and a pair of jaws adapted to move distally relative to the apparatus to squeeze the clip closed about a blood vessel.

A trocar (claim element at 1 a) is an instrument that comprises a cutting tip, cannula or tube, and valve means for sealing the tube. The tube or cannula is in-

serted through the incision wound made by the cutting tip of the trocar into the body and an endoscopic multiple clip applier as defined in claim element 1 b) is then inserted through the cannula or tube into the body cavity.

USSC contends that the clip closing means as set forth in claim 1 should be given a definition as encompassed within the '420 specification as appearing at column 4, lines 23-25, as "comprising a pair of flexible opposing jaws which are cammed together into closure by a distally-moving channel . . ." for sequentially closing the clips. On the other hand, J&J contends that in order for the clip closing means to *sequentially* close a plurality of surgical clips, such means necessarily includes the mechanism that advances the clips for sequential closure, the escapement mechanism that limits sequential feeding to one clip at a time, as well as the jaws and cam channel used to form and close the clips. J&J contends that these structures are all necessary to the seqential clip closure (See Mann Affidavit, para. 5).

J&J further contends that the process of the '420 Patent discloses a semi-automatic mechanism for sequentially closing the clips. When one clip is in the jaws of the instrument, the surgeon can close that clip by squeezing the instrument's handle, but releasing the handle does not cause the next clip to automatically advance to sequential closure. In order to position the next clip for sequential closure, the surgeon has to press a separate release button, which releases a locking mechanism, which in turn allows the instrument's pusher bar to move forward and advance the next clip. J&J contends that the semi-automatic mechanism in the '420 Patent is a consequence of the structure disclosed in the '420 specification, particularly, J&J points to Figure 34A of the '420 Patent which shows the dimensional relationship between the jaws in their open position and the interior diameter of the trocar cannula. The Figure shows that the jaws

in their open position are substantially wider than the interior diameter of the trocar cannula. J&J concludes that the design of the '420 device resulted in this jaw structure because USSC was of the view that wide jaws were needed to provide the requisite force to close the clips. However, having jaws that are wider than the interior diameter of a cannula means that the jaws will partially close whenever the instrument is inserted into, or taken out of, a cannula. If that happened while a clip was in the jaws, there is a danger that the partially deformed clip would drop out of the jaws and into the body cavity. Thus, in order to prevent this, USSC designed a locking mechanism giving rise to the semi-automatic operation of the device. The locking mechanism prevents the next clip from advancing automatically into the jaws for sequential closure *until the surgeon presses a separate release button,* as specified at column 14, lines 56-60. This permits the instrument to be inserted into or removed from a cannula without a clip in the jaws, but J&J contends that this necessarily means that the device cannot automatically advance clips for sequential closure.

In contrast, the J&J accused devices have an automatic mechanism for sequentially closing a plurality of surgical clips. The clips are advanced automatically into the jaws without a separate safety or release mechanism because the jaw structure utilized by defendants is allegedly substantially different from the jaw structure disclosed in the '420 Patent. The jaws in their open position are narrower than the interior diameter of the cannula into which the instrument is inserted. Because of the narrow jaws, the accused devices can pass through a cannula with a clip in the jaws without deforming the clip in the jaws and therefore without any danger of dropping the clip. (See Mann Affidavit, para. 6-14 inclusive).

Thus, J&J urges an interpretation of Claim 1 which requires clip closing means for sequentially closing the

clips which relies on a separate mechanism for releasing the clips to the jaws one at a time under positive action and control of the surgeon.

J&J also contends that facts and issues also exist as to the interpretation of "seal means" specified in Claim 1 of the '420 Patent. J&J contends that the sealing means disclosed in the '420 Patent are not identical to those in the accused devices and would not be covered by the sealing means recited in Claim 1. In the '420 Patent, a seal is provided by "close tolerances with the internal moving parts" (Column 4, lines 68 *et seq.*). The structure disclosed for providing those tolerances consists of a "sealing block" formed from two U-shaped pieces that are joined together leaving an "axially extending" opening through which the pusher bar and cam channel can be disposed. (Column 5, lines 4-16). The surfaces of the sealing block are shown in close continuity with the cam channel and pusher bar. A layer of grease can be employed to fill the spaces between the parts in the inner surfaces of the sealing block.

It is argued that in contrast, the accused devices do not use a solid sealing block as disclosed in the '420 Patent, but J&J's devices employ a hollow compartment with five separate but adjacent chambers. There are narrow walls separating these hollow chambers and sealing occurs at the openings in the narrow walls between each of the chambers. Grease is inserted into the central chamber and is drawn into the narrow openings in the walls of the multiple chambers by movement of the cam channel and feed bar. It is contended that the sealing mechanism in the accused devices is different than in the '420 Patent in that the series of narrow walls and hollow chambers in the accused devices provides what is called a "labyrinth seal" and that the sealing pressure drop is spread over five separate, narrow surfaces; whereas, in the patented device the total pressure drop must take place along the single sealing block in order for the seal to function.

USSC vigorously opposes the contention that there are genuine facts in dispute. Further, USSC argues that the means for sealing the accused devices is based on the same close tolerances between the parts as disclosed and utilized in the '420 Patent structure.

The Applicable Legal Standards Governing Disposition of the Motion

Before discussing why summary judgment is inappropriate at this stage of the proceedings, a caveat would appear to be in order. There is no question that a claimed "means" for performing a particular function is not limited to the particular embodiments set forth in the specification. The patentee is only required to disclose a particular empodiment in the specification as a means for accomplishing the function set forth in the patent claim. There is certainly no requirement that a patentee describe or predict every potential means of accomplishing the function set forth in the claim. *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985). Otherwise, 35 U.S.C. § 112(b)(6) would have no meaning. To hold otherwise would be to nullify the provision of the statute requiring that means-plus-function limitations be construed to cover the structure described in the specification *and equivalents thereof. Pennwalt Corp. v. Durand- Wayland, Inc.*, 833 F.2d 931, 934 (Fed.Cir. 1987). Therefore, it is entirely possible that while the clip closing means for sequentially closing the clips and the sealing means of claim 1 may not be the same as in J&J's devices, they nevertheless may be considered equivalent when applying the test enunciated in *Valmont Industries, Inc. v. Rinke Manufacturing Co., Inc.*, Case. No. 91-1377, 1378 (Fed.Cir. 1993). An equivalent results from a use of an insubstantial change which adds nothing of significance to the structure or acts disclosed in the patent specification.

However, where, as here, there is some element of doubt as to the true scope of the claims in light of the

prior art and expert testimony concerning what one of ordinary skill in the art would have known at the time the invention was made,, the Court should reserve judgment as to the scope and interpretation of the claims until all of the evidence is in. *See: Palumbo v. Don-Joy Co.*, 762 F.2d 969, 973 (Fed. Cir. 1985).

As stated in *Palumbo* at 975 (Fed. Cir. 1985):

> "[An] infringement inquiry is broken down into two steps: first, the scope of the claims must be ascertained, and then the trier must decide whether the claims cover the accused device. The latter step, which is the ultimate determination of infringement is a fact issue. . .
>
> "Construction of a claim, *a question of law,* is necessary to define the metes and bounds of the protection afforded by the claims. If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law . . . but when the meaning of a term is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises and construction of the claim should be left to the trier or the jury under appropriate instruction."

Thus, both steps in the two-part inquiry to infringement may present factual matters not appropriately resolved in a motion for summary judgment. *Union Carbide v. Tarant Corp.*, 682 F.Supp. 535.

This principal has been endorsed by the Court of Appeals for the Federal Circuit. *Howes v. Medical Component, Inc.*, 814 F.2d 638; *Tillotsin Limited v. Walboro Corp.*, 945 F.2d 1549, holding that if expert testimony is needed to explain a disputed term or expert evidence will be helpful in determining the thrust and meaning of the prosecution histories and prior art, though claim interpretation is a question of law, there is no prohibition on the Court's obtaining potentially useful aid in under-

standing and determining these underlying factual questions. Summary judgment, under such circumstances, would be improper.

Claim interpretation is a function for the Court, not the jury. In a jury case, the Court must instruct the jury on the scope and meaning of the claim. The jury's sole role is to determine whether the invention, as defined by the Court, has been made and sold by the defendants. *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992). The Court, however, welcomes expert extrinsic evidence in order to aid it in its interpretation of the claim. Then, the Court will formulate appropriate instructions for the jury on the meaning of the claim and the jury will be the ultimate trier of fact as to whether the claimed elements, as interpreted by the Court, are found in the accused's devices. This may also include a determination, if the jury finds no literal infringement, of whether the invention in the accused's device infringes under the doctrine of equivalents. This determination is strictly within the providence of the jury and is a question of fact. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

Conclusion

Based on the foregoing anaylsis, there is still a substantial question concerning the scope of claim 1. Therefore, USSC's motion for summary judgment (Docket Entry No. 240) is DENIED.

Date: March 5, 1993

/s/ Barry Kramer
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APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

91-1393, -1394, -1409

PALL CORPORATION,
Plaintiff/Cross-Appellant,

v.

MICRON SEPARATIONS, INC.,
Defendant-Appellant.

92-1049

HERBERT MARKMAN and POSITEK, INC.,
Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC., and
ALTHON ENTERPRISES, INC.,
Defendants-Appellees.

ORDER

On further consideration of the appeals now pending before the court in banc, and because the above appeals raise significant issues related to interpretation of a claim in a patent, it is

ORDERED that additional briefing by the parties and by amici curiae may be filed as follows:

The briefs for appellants on rehearing in banc shall be filed on or before February 14, 1994. The briefs for appellees on rehearing in banc shall be filed on or before March 14, 1994.

The court is particularly interested in briefing on:

(1) Are disputes over the meaning of a term in a claim (a) issues of law to be decided on a documentary record, similar to questions of statutory construction, or (b) are there some claim construction disputes that can only be resolved by resort to extrinsic evidence which requires the taking of factual and expert testimony?

(2) If factual or expert testimony is proffered to resolve a particular dispute, what are the respective roles of the trial judge and jury?

(3) When a claim construction dispute is on appeal to this court, what is the standard of review this court should apply to the judgment below on the merits? With regard to permissible post-trial motions?

(4) When the meaning of a claim term must be decided in the course of deciding the question of infringement, what are the respective roles of trial judge and jury?

Amicus curiae briefs on rehearing in banc may be filed in accordance with Rule 29.

Oral argument will be scheduled after the briefs have been filed.

Briefs shall be filed in 30 copies.

FOR THE COURT

/s/ Francis X. Gindhart
FRANCIS X. GINDHART
Clerk

[Filed Jan. 7, 1994]

APPENDIX F

SUMMARY OF ARGUMENT, U.S. SURGICAL'S OPENING BRIEF FEDERAL CIRCUIT (Aug. 18, 1994)

III. SUMMARY OF ARGUMENT

U.S. Surgical seeks relief from a verdict that resulted from a trial in which the District Court disregarded this Court's repeated admonitions as to the proper role of a judge and a jury in a patent case. As is clear, the trial of a patent case should be very different from the trial of a common law negligence case. The goal in a patent case is to implement the national patent law. Its fair enforcement is not permitted to fluctuate with the idiosyncratic community sense of any one jury. *Strutctural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 723, 223 USPQ 1264, 1276 (Fed. Cir. 1984). It is therefore of paramount importance that the jury be properly informed of its fact-finding role, and that only disputed issues of fact be submitted to it. *Id.* at 713-14, 720-21, 722, 223 USPQ at 1268-69, 1274, 1275. This means that the trial court must perform its role of properly instructing the jury on the meaning of patent claims. It means that the trial court must instruct the jury on the material provisions of 35 U.S.C. § 103. It also means that the trial court must strongly dispel the plea of an infringer that it be allowed, in the name of competition, to continue to sell its product.

Contrary to these established norms for trying a patent case, the District Court did not define the meaning of the patent terms. It did not reasonably instruct on "obviousness." It took no action to overcome improper, inflammatory, and prejudicial argument from Ethicon. The Court invited the jury to function as the proverbial "black box into which patents are thrown [to] emerge intact or invalid by an unknown or unknowable process." *Id.* at 718 & n. 7, 223 USPQ at 1272 & n. 7.

The unguided jury, on its first day of deliberation, requested a dictionary. Rather than inform and guide the jury through proper instruction as this Court has admonished, *see, e.g., Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 n. 3, 23 USPQ2d 1426, 1432 n. 3 (Fed. Cir. 1992); *Genentech Inc. v. Wellcome Found. Ltd.*, —— F.3d ——, 31 USPQ2d 1161, 1165 & n. 6, 1172 n. 47 (Fed. Cir. 1994), the District Court highlighted and compounded its unwillingness to define the patent terms by providing the jury with *Webster's New World Dictionary* over the objection of both parties.

As in most patent cases, the material underlying facts were generally not in dispute. Here, the identity and content of the prior art was clear. The patent claims were clear, and not obfuscable. The material facts established non-obviousness, and '057 as well as '420 infringement. This appeal, therefore, seeks reversal and a remand for prompt entry of an injunction in favor of U.S. Surgical, as well as a trial on damages; or, in the alternative, in vindication of its right to an informed decision, *Structural Rubber*, 749 F.2d at 713, 223 USPQ at 1268, U.S. Surgical requests a remand for a new trial. *Genentech*, —— F.3d ——, 31 USPQ2d at 1172 n. 47.

APPENDIX G

FEDERAL CIRCUIT RULE 36

Rule 36. Entry of Judgment

Judgment of affirmance without opinion. The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following circumstances exist:

(a) the judgment, decision or order of the trial court appealed from is based on findings that are not clearly erroneous;

(b) the evidence in support of a jury verdict is sufficient;

(c) summary judgment, directed verdict, or judgment on the pleadings is supported by the record;

(d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or

(e) a judgment or decision has been entered without an error of law;

and an opinion would have no precedential value.